Supreme Court, U.S.
FILED

No. D 07-527 OCT 22 2007

OFFICE OF THE CLERK

# In The Supreme Court of the United States

WILLIAM DARDEN,

*Petitioner,*

v.

MARYBETH PETERS,
Register of Copyrights,

*Respondent.*

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

## PETITION FOR WRIT OF CERTIORARI

Anthony J. Biller
*Counsel of Record*
COATS & BENNETT, PLLC
1400 Crescent Green, Suite 300
Cary, North Carolina 27518
(919) 854-1844

*Counsel for Petitioner*

THE LEX GROUP DC ♦ 1750 K Street N.W. ♦ Suite 475 ♦ Washington, DC 20006
(202) 955-0001 ♦ (800) 815-3791 ♦ Fax: (202) 955-0022 ♦ www.thelexgroupdc.com

## QUESTIONS PRESENTED FOR REVIEW

1. When the Copyright Office refuses registration of a copyright based on a conclusion that the work lacks the constitutional prerequisite of "originality," has the Office made a finding regarding the existence of a property right contemplated under the Constitution that is subject to de novo review under the "contrary to constitutional right [or] power ..." provision of the Administrative Procedures Act, 7 U.S.C. § 706(2)(B)?

2. May the Copyright Office refuse to register a copyright based on its concluding that the authored elements viewed in isolation are not copyrightable and that when viewed in combination the work is simply "entirely typical"?

3. Is evidence of third party recognition of the distinctiveness of maps relevant for rebutting an assertion by the Copyright Office that the maps are mere representations of public domain maps lacking any sufficiently creative expression to warrant copyright registration?

## TABLE OF CONTENTS

Page

QUESTIONS PRESENTED FOR REVIEW ..... i

TABLE OF CONTENTS ..... ii

TABLE OF AUTHORITIES ..... v

OPINIONS BELOW ..... 1

BASIS FOR JURISDICTION ..... 1

CONSTITUTIONAL PROVISION AND STATUTES AT ISSUE ..... 2

STATEMENT OF THE CASE ..... 4

REASONS FOR GRANTING THE WRIT ..... 8

1. The Fourth Circuit's holding that the Copyright Office's analysis of copyright originality did not present an issue of constitutional analysis subject to review under 15 U.S.C. § 706(2)(B) is contrary to the Court's holdings in *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340, 347 (1991) and *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884) ..... 8

2. The Fourth Circuit's affirming that the Copyright Office may refuse registration for lack of originality based on a conclusion that the authored elements when viewed in combination are "entirely typical" misapplies the Court's holding in *Feist Publications v. Rural Telephone Service Co.* and conflicts with the District of Columbia Circuit's holdings in *Atari Games Corp. v. Oman* ..... 13

3. The Fourth Circuit erred as a matter of law by holding that marketplace acknowledgement of the uniqueness of Darden's maps is irrelevant to the issue of copyright originality ..... 18

CONCLUSION ..... 21

APPENDIX

Opinion of
The United States Court of Appeals
For the Fourth Circuit
entered May 24, 2007 ..... 1a

Order of
The United States District Court
For the Eastern District of North Carolina
entered December 6, 2005 ..... 22a

Order of
The United States Court of Appeals
For the Second Circuit
Re: Denying Petition for Rehearing
entered July 23, 2007 ..... 35a

U.S. CONST. art. I, § 8, cl. 8 ..... 36a

5 U.S.C. § 702 ..... 37a

5 U.S.C. § 703 ..... 38a

5 U.S.C. § 706 ..... 38a

17 U.S.C. § 102 ..... 39a

17 U.S.C. § 103 ..... 40a

17 U.S.C. § 410 ..... 41a

17 U.S.C. § 411 ..... 42a

17 U.S.C. § 412 ..... 43a

17 U.S.C. § 701 ..... 44a

28 U.S.C. § 1338(a) ..... 46a

37 C.F.R. § 302.1 ..... 47a

Petition for Rehearing
filed July 6, 2007 ..... 48a

Map of Alaska
undated ..... 57a

## TABLE OF AUTHORITIES

**Page(s)**

### CASES

*Alfred Bell & Co. v. Catalda Fine Arts*,
191 F.2d 99 (2d Cir. 1951) ..... 9, 20

*Atari Games Corp. v. Oman*,
888 F.2d 878 (D.C. Cir. 1989)..... 12, 13, 16, 17

*Atari Games Corp. v. Oman*,
979 F.2d 242 (D.C. Cir. 1992)..... 12, 17, 18, 20

*Bleistein v. Donaldson Lithographing Co.*,
188 U.S. 239 (1903) ..... 9

*Burrow-Giles Lithographic Co. v. Sarony*,
111 U.S. 53 (1884) ..... 8, 9

*Eltra Corp. v. Ringer*,
579 F.2d 294 (4th Cir. 1 978)..... 12

*Esquire, Inc. v. Ringer*,
591 F.2d 796 (D.C. Cir. 1978)..... 12

*Feist Publications, Inc. v.*
*Rural Telephone Service Co.*,
499 U.S. 340 (1991) .....*passim*

*Gerlach-Barklow Co. v. Morris & Bendien, Inc.*,
23 F.3d 159 (2d Cir. 1927)..... 20

*Godinger Silver Art Co. v. International Silver Co.*,
1995 WL 702357 (S.D.N.Y. Nov. 28, 1995)... 20

*Imperial Laces Inc. v. Westchester Lace Inc.*,
1998 WL 830630 (S.D.N.Y. Nov. 30, 1998)... 20

*J.L. Mott Iron Works v. Clow*,
82 F. 316 (7th Cir. 1897)..... 9

*OddzOn Prod., Inc. v. Oman*,
924 F.2d 346 (D.C. Cir. 1991)..... 12

*Two Pesos, Inc. v. Tacao Cabana, Inc.*,
505 U.S. 763 (1992) ..... 18-19

**CONSTITUTIONAL PROVISION**

U.S. CONST. art. I, § 8, cl. 8..... 2

**STATUTES**

5 U.S.C. § 702 et seq..... 7

5 U.S.C. § 706 ..... 3, 4

5 U.S.C. § 706(2)(A)..... 13

5 U.S.C. § 706(2)(B)..... 7, 9, 10

15 U.S.C. § 706(2)(B)..... 8, 9, 13

17 U.S.C. § 101 ..... 11

17 U.S.C. § 102 ..... 2

17 U.S.C. § 103 ..... 2

17 U.S.C. § 701(e) ..... 7

28 U.S.C. § 1254(1) ..... 1

**REGULATION**

37 C.F.R. § 202.1(a) ..... 8, 14

**OTHER AUTHORITIES**

Howard B. Abrams,
The Law of Copyright § 2:2 (Oct. 2006) ..... 12

James E. Hawes, et al.,
Copyright Registration Practice
§ 22:10 (2nd ed. (database) 2007) ..... 11

Petitioner William Darden respectfully prays the Court to issue a writ of certiorari to review the judgment and opinion of the United States Court of Appeals for the Fourth Circuit entered in the above titled proceeding on May 24, 2007.

## OPINIONS BELOW

The opinion of the Court of Appeals for the Fourth Circuit is reported at 488 F.3d 277, 82 U.S.P.Q.2d 1751 (4th Cir. 2007), and is reprinted in the appendix hereto. (*See infra* p. 1a.)

The opinion on motion for reconsideration of the Court of Appeals for the Fourth Circuit is not reported. It is reprinted in the appendix hereto. (*See infra* p. 35a.)

The opinion of the United States District Court for the Eastern District of North Carolina is reported at 402 F. Supp. 2d 638, 77 U.S.P.Q.2d 1403 (E.D.N.C. 2005), and is reprinted in the appendix hereto. (*See infra* p. 22a.)

## BASIS FOR JURISDICTION

On July 23, 2007, the United States Court of Appeals for the Fourth Circuit denied Petitioner's motion for reconsideration of the judgment and opinion entered May 24, 2007. The jurisdiction of the Court to review the judgment of the Fourth Circuit is invoked under 28 U.S.C. § 1254(1).

## CONSTITUTIONAL PROVISION AND STATUTES AT ISSUE

Article I, § 8, cl. 8, of the Constitution is at issue:

> The Congress shall have power ... To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries;

The statutes involved are the copyrightability provisions of the Copyright Act, 17 U.S.C. §§ 102, 103:

> § 102. Subject matter of copyright: In general
> (a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or ... (5) pictorial, graphic, and sculptural works; ...
>
> § 103. Subject matter of copyright: Compilations and derivative works
>
> (a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, ....

> (b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

The review provisions of the Administrative Procedures Act, 5 U.S.C. § 706, are also at issue:

> To the extent necessary to decision and when presented, the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of an agency action. The reviewing court shall—
>
> (1) compel agency action unlawfully withheld or unreasonably delayed; and
>
> (2) hold unlawful and set aside agency action, findings, and conclusions found to be—
>
> (A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law; [or]
>
> (B) contrary to constitutional right, power, privilege, or immunity; ...

> In making the foregoing determinations, the court shall review the whole record or those parts of it cited by a party, and due account shall be taken of the rule of prejudicial error.

5 U.S.C. § 706.

## STATEMENT OF THE CASE

The facts are relatively straightforward and undisputed. Petitioner William Darden created APPRAISERSdotCOM, an online advertising service that helps people locate real estate appraisers serving any county in the USA. (R. 91, ¶ 2.)[1] Mr. Darden uses a stylized map of the United States on the APPRAISERSdotCOM home page and stylized maps of individual states on the pages for the respective states. (*See* R. 80 – 83.) The maps were authored by a professional developer, Mr. Sean Pecor. Starting with digital maps from the United States Census, Mr. Pecor resized the maps, redrew "anti-aliased" lines to soften and to render the map lines more smoothly and aesthetically pleasing. Mr. Pecor then gave the redrawn maps three-dimensional effects by selecting and shading select portions of the maps. (R. 292, 294, 298, 311.) He selected and applied colors and fonts throughout the maps. He also created labeling and call-outs, selected what to label and call-out, and determined where to place these elements. (R. 117, ¶ 3.) An exemplar of one of the state maps may be viewed in

---

[1] Citations to the Record refer to the Joint Appendix filed with the United States Court of Appeals for the Fourth Circuit on April 20, 2006.

the appendix hereto at page 57a. (R. 292 (same map).) Mr. Pecor assigned all of his copyrights in the maps to Mr. Darden in 1999. (*Id.* ¶ 4.)

Over the years, third parties recognized the maps as being unique and distinctive to Mr. Darden. (*See* R. 92 – 93, ¶¶ 4 – 7.) Consumers requested permission from Mr. Darden to use the maps. (R. 92, ¶ 4.) When competing websites copied Mr. Darden's maps, Mr. Darden's customers notified him because they thought he owned the other websites since they displayed his maps. (*See* R. 92 – 93, ¶¶ 4 – 7.) When asked, competitors acknowledged Mr. Darden's copyrights and removed his maps from their websites. (R. 92, ¶ 6.)

Given the ease and prevalence of "click and copy" on the internet, Mr. Darden decided to register the copyrights in his maps and in his web page design. In 2002, he submitted two applications for copyrights, one in the technical drawing copyright for his website, referred to as "APPRAISERSdotCOM" and the other for the maps on his website, referred to as "Maps for APPRAISERSdotCOM." Mr. Darden disclosed that the maps were derivatives of US Census maps and explained that the material added to the original work included "font and color selection; visual effects such as relief, shadowing, and shading; labeling; call-outs." (R. 287.)

The Office found that the maps lack the originality necessary to support a copyright claim and also denied registration for the website on grounds not relevant to this petition. (R. 119 – 20.)

Mr. Darden appealed the Office's refusal to register, explained that

> [t]he "creative spark" that makes Mr. Darden's maps eligible for protection are the overall design – the special combination of font and color selection; visual effects such as relief, shadowing, and shading; labeling; and call-outs. The information the map provide could easily be provided in other ways; thus, the author should be allowed to protect his creative efforts.

(R. 105.), and submitted the declaration of Mr. Pecor to set forth the creative efforts that went into authoring the stylized maps. (R. 117.)

The Office again refused registration, stating "[t]he changes made to the maps in these works amount to little more than layout or format, which as previously stated, are not copyrightable." (R. 96.) Exhausting his administrative appeals, Mr. Darden again requested reconsideration in a letter dated April 2003. (R. 86 – 93.) He clarified that the Office must look to the design of the maps as a whole and not focus on isolated elements. (R. 87.) Mr. Darden also explained that his maps are copyrightable since the information they provide could be provided in numerous ways. (*Id.*) In an accompanying declaration, Mr. Darden explained that consumers recognize the distinctiveness of his stylized maps. (R. 89, 91 – 93.) The Office denied Mr. Darden's second appeal. (R. 68 – 79.) In viewing the elements of the maps in their entirety, the Office concluded, "The arrangement of the names, call-outs, shading,

and color is 'entirely typical' and does not establish a basis for establishing the requisite level of creative authorship necessary to sustain a copyright in a map or any other work." (R. 75.) The Office did not explain how or provide evidence to demonstrate why it determined that Mr. Darden's stylized maps were "entirely typical." The Office also categorically rejected the relevance of third party recognition of the maps. (R. 76.)

Mr. Darden appealed the Office's decision to the United States District Court for the Eastern District of North Carolina, pursuant to 17 U.S.C. § 701(e) and 5 U.S.C. § 702 et seq. In deciding cross-motions for summary judgment in favor of the Office, the trial court rejected Mr. Darden's argument that the Office's analysis of "originality" should be subject to de novo review, acknowledged that the Constitution empowers Congress to protect copyrights in original works and that Congress has vested such power in the Register of Copyrights, and that the Office did not abuse its discretion in refusing registration. (A. 22a – 34a.)

In the course of affirming the trial court, the Fourth Circuit acknowledged that constitutional questions that arise during APA review fall expressly within the domain of the courts under the APA. The panel then held that "[c]opyright is solely a creature of statute; whatever rights and remedies exist do so only because Congress provided them. ... Thus, as there is no constitutional right to copyright registration, the Register's refusal to register ... cannot be 'contrary to constitutional right' as it must be for § 706(2)(B) to apply." (A. 12a.) The court also

found that elements in the maps resemble the list of examples of uncopyrightable works set forth in 37 C.F.R. § 202.1(a) (A. 18a), and that evidence of marketplace recognition of the maps "is the hallmark of trademark law, not copyright." (A. 19a.) Finding no abuse of discretion, the court affirmed.

## REASONS FOR GRANTING THE WRIT

**1. The Fourth Circuit's holding that the Copyright Office's analysis of copyright originality did not present an issue of constitutional analysis subject to review under 15 U.S.C. § 706(2)(B) is contrary to the Court's holdings in *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340, 347 (1991) and *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).**

The Constitution empowers Congress to protect the "writings" of authors, the right of such protection recognized in the form of copyright. Congress has long since decided that "maps" are "writings" for purposes of copyright protection. The issue contested before the Copyright Office was whether Mr. Darden's maps are copyrightable or, in constitutional parlance, whether the maps constitute "writings" that may be protected. The Court has long recognized that the definition of what constitutes a copyright is ultimately a constitutional question and that the Constitution mandates a work be an "original" work of authorship to warrant copyright protection. When the Copyright Office makes determinations of copyrightability based on the issue of originality, it conducts a constitutional

analysis that should be subject to de novo review under 15 U.S.C. § 706(2)(B).

The property right of copyright derives directly from the constitutional grant to Congress of the power to protect an author's "writings." To be protected by copyright, the Constitution requires "writings" to be sufficiently original. "Originality is a constitutional requirement." *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 346 (1991). The Court has repeatedly explained that the base requirement for copyright is "originality" and that the Constitution mandates this standard. *Id.* at 345 – 47; *accord Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884); *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 102 – 03 (2d Cir. 1951); *J.L. Mott Iron Works v. Clow*, 82 F. 316 (7th Cir. 1897). As far back as 1884, the Court stated that whether a work was copyrightable constituted a difficult question of *constitutional* law. *Burrow-Giles Lithographic*, 4 U.S. at 280. More recently, the Court thoroughly explained the constitutional basis for copyright originality in its analysis in *Feist*. The Copyright Office's analysis of copyright originality presented a question of constitutional law.

Mr. Darden disputes that the Office properly decided the constitutional prerequisites for copyright. A copyright is, per se, a right. Section 706(2)(B) of the APA requires de novo review of agency decisions that involve a constitutional right. Mr. Darden believes his maps contain- the "originality" required by the Constitution. Courts

should not afford deference to the Copyright Office's determination of whether constitutional prerequisites have been satisfied for purposes of copyright.

The Fourth Circuit misconstrued Darden's § 706(2)(B) argument. The Panel described Darden as arguing that the constitutional right at issue was his right to register his works. (A. 11a – 12a.)

The constitutional "right" disputed in this case relevant to § 706(2)(B) is not a registration right or any other individual right. Darden does not argue he has an individual right under the Constitution to register a copyright. The "right" implicated is a property right, specifically, whether constitutional jurisprudence recognizes Darden's "writings" as sufficiently "original," i.e., whether a copyright exists. The word "right" in § 706(2)(B) is not limited to "individual" rights but involves any right under the Constitution, to include the property right the Constitution recognizes as original writings, which Congress may protect and with regard to maps has chosen to protect.

The Fourth Circuit further misstated the nature of copyright, asserting "[c]opyright is *solely* a creature of statute." (A. 12a (emphasis added).) To the contrary, copyright is a right born directly out of the Constitution. Whether and to what extent the laws protect copyright is left to the discretion of Congress. Congress exercised that power and delegated certain authority to the Copyright Office. When the Copyright Office invokes constitutional

standards for determining the existence of copyright, its determinations should be subject to de novo review.

In its brief before the Fourth Circuit, the Government took the position that courts always afford the Office deference regarding the denial of a registration for lack of copyrightable subject matter. The Fourth Circuit's holding implicitly states that copyright registration decisions should always be reviewed under an abuse of discretion standard. The first commentary on the case draws the same conclusion. *See* James E. Hawes, et al., Copyright Registration Practice § 22:10 n. 1.5 (2nd ed. (database) 2007) ("A judicial review of the Register's refusal to register a claim is brought under the Administrative Procedure Act based on an abuse of discretion and it cannot be reviewed de novo.")

There are a line of cases that hold the Office to an abuse of discretion review. Upon scrutiny, however, there is an important distinction in nearly all these cases. Congress decided where and to what extent to extend copyright protection. By doing so, Congress set forth subject matter that may be copyrighted. For example, Congress extended copyright protection to maps but not to useful articles, i.e., "industrial designs." *See* 17 U.S.C. § 101 (definition for "Pictorial, graphic, and sculptural works"). The Copyright Office was left to interpret what these areas of subject matter included.

There has been significant litigation regarding the definition of where Congress drew the lines of copyrightable subject matter under the Copyright

Act, such as for "useful articles." *See, e.g., OddzOn Prod., Inc. v. Oman*, 924 F.2d 346 (D.C. Cir. 1991); *Eltra Corp. v. Ringer*, 579 F.2d 294 (4th Cir. 1978); *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978). In such litigation, courts properly afford the Copyright Office discretion in construing the subject matter boundaries set by Congress, such as defining what constitutes a "useful article."

This is not a case contesting how the Copyright Office construed "useful articles," what constituted a "map," or any other statutory line set by Congress. There is no dispute that a map is copyrightable subject matter and that Darden submitted maps for registration. This is a dispute over the Office's decision that Darden's maps lacked sufficient originality. The prerequisite of originality derives from the Constitution and necessarily involves a constitutional question.[2] *See Feist*, 499 U.S. 346 – 47.

There is one circuit case, over two holdings, that specifically addresses the standard of review for the Office's denial of registration based on a finding of insufficient originality. *See Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989); *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C. Cir. 1992). In the *Atari* holdings, through then Judge Ginsberg, the D.C. Circuit stated it was giving deferential review to the Office's analysis of "originality," but in practice the court gave no deference. Importantly, the frustrated applicant, *Atari*, only pursued appeal

---

[2] "[I]t seems self-evident that Congress could not constitutionally create a lower standard of originality ...." Howard B. Abrams, The Law of Copyright § 2:2 (Oct. 2006).

on the abuse of discretion standard of 5 U.S.C. § 706(2)(A). *Atari Games*, 888 F.2d 879. The circuit court twice rejected the Office's proffered analysis of originality. Aside from one concurring opinion, the court gave little defense of or analysis of the deferential standard of review. It was the only standard Atari pursued. The concurring opinion offered a pragmatic rationale for that standard. *See Oman*, 888 F.2d at 886 – 87 (Silberman, J., concurring). That "originality" is a constitutional requirement for copyright was not raised, let alone analyzed in the opinions.

"Originality" is a constitutional pre-requisite for copyright protection. The Constitution imposes the requirement. When the Copyright Office decided that Darden's works did not exhibit sufficient originality, the Office decided that a requirement imposed by our Constitution had not been satisfied. An incorrect analysis of a constitutional property right is "contrary to constitutional right." Review should be had under 15 U.S.C. § 706(2)(B).

**2. The Fourth Circuit's affirming that the Copyright Office may refuse registration for lack of originality based on a conclusion that the authored elements when viewed in combination are "entirely typical" misapplies the Court's holding in *Feist Publications v. Rural Telephone Service Co.* and conflicts with the District of Columbia Circuit's holdings in *Atari Games Corp. v. Oman*.**

In its analysis, the Copyright Office reviewed individual elements of Darden's maps, and concluded

that each element, in isolation, was not copyrightable. The Office then acknowledged its duty to analyze the elements as a whole, and, while citing *Feist*, immediately concluded that the arrangement of these elements is "entirely typical" and did not rise to the level of creative authorship necessary to sustain a copyright. (R. 74 – 75.) No where in the administrative record, at the District Court, or in its appeal briefs before the Fourth Circuit did the Office explain why the elements when taken as a whole are "entirely typical."[3] Nonetheless, the Fourth Circuit found that the Copyright Office cited uncopyrightable elements in the maps and held that additions such as color, shading, and labels "fall within the narrow category of works that lack even a minimum level of creativity ..." similar to the standards set forth in 37 C.F.R. § 202.1(a). (A. 18a.)

In *Feist*, the Court found the works at issue "entirely typical" and dedicated several paragraphs to explaining the basis for this conclusion. *See Feist*, 499 U.S. at 362. Read in context, the Court's use of "entirely typical" does not appear intended to set a legal standard for evaluating originality. Rather, the Court observed that the phone book pages at issue in that case appeared the same as telephone listings found anywhere else. Earlier in the opinion, the Court emphasized that the uniqueness or novelty of a work is irrelevant for purposes of determining originality. "Originality does not signify novelty; a

---

[3] To the contrary, the only record evidence was that the maps were not typical, that customers and competitors alike acknowledged the maps as unique and proprietary to Mr. Darden. (R. 92 – 93.)

work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying." *Feist*, 499 U.S. at 345.

The Office erred in using "entirely typical" as its standard for evaluating the elements contributed to Mr. Darden's maps in combination. The Fourth Circuit erred by holding that the Office's analysis of the individual elements was sufficient.

From a practically infinite palate of potential colors, the Darden maps reflect a particular shade of blue, a different color for the political boundaries, another color for the shading, yet another shade of blue for water, callout boxes in black, and the use of white for font coloring. (*See* R. 292 – 346; A. 57a.) The author selectively used and creatively placed shading throughout the images. (*See, e.g.*, R. 292 (A. 57a), 294, 298, 311.) He determined when to selectively use callouts and where to place them, and in limited instances when and where to place numbered reference notes. (*See* R. 292 – 346.) The author used and placed the enumerated reference notes and the callout boxes in a balanced and creative manner. (*See, e.g.*, R. 292, 298, 300, 322, 340, 341.) He redrew the boundaries to soften the maps' appearance. (R. 116.) The combination of all these elements over dozens of maps creates a distinctive and unique creative effort. (*See* R. 292 – 346.) The Darden maps are unique and distinctive, and the countless combinations of the various elements over dozens of images makes them substantially more creative than an alphabetical listing of names, the object of analysis in *Feist*. The

analysis condoned by the Fourth Circuit provides no guidance or illumination as to why the combination of these elements is not copyrightable. Further, the Fourth Circuit's holding on the Office's analysis of a combination of elements contradicts holdings from the District of Columbia Circuit.

The D.C. Circuit rejected and remanded the same type conclusory analysis on the copyrightability of a combination of elements. The Copyright Office refused to register the copyright in Atari's video game BREAKOUT. The video images consisted of a wall comprising colored rectangles, a rectangular shaped paddle, and a square ball. Sounds and tones accompanied the playing of the game. The Copyright Office (twice) refused registration, claiming that the work "as a whole" lacked sufficient originality to warrant registration; its analysis consisted of explaining why the individual elements lacked sufficient originality and were dictated by functional concerns. *Atari Games*, 888 F.2d 879 – 80.

In the first *Atari* holding, then Judge Ginsberg writing for the court expressed concern that the Office fixated on a component-by-component analysis of Atari's videogame. The court reminded the Office that, while component parts of a work may be neither original nor copyrightable, the elements in combination may create a separate entity that is both original and copyrightable. *Atari*, 888 F.2d at 882 – 83. The court further reminded the Office that the "level of creativity necessary and sufficient for copyrightability has been described as 'very slight,' 'minimal,' and 'modest.'" *Id.* at 883. The court was

concerned that the Office's decision did not harmonize with prior office actions and court rulings on the creativity threshold. *Id.* at 884. In reversing the trial court's affirmance, the court stated,

> [w]e are unable to detect from the final decision before us the standard the Registrar is using to differentiate material that cannot constitute copyrightable subject matter and therefore should not be registered, from material that may be copyrightable, although perhaps meriting only "thin" protection when the character of its "expression" is tested in an infringement suit.

*Id.* at 886.

In the second *Atari* holding, which then Judge Ginsburg referred to as "the replay of the match," the court again reversed the district court for being too deferential to the Office's second refusal to register Atari's works, this time holding that the Office's rejection of the works was unreasonable in light of "the Supreme Court's instruction that 'the requisite level of creativity [for copyrightability] is extremely low.'" *Atari*, 979 F.2d at 243 (citing *Feist*). The court expressed its concern that the Office "may have" focused too closely on individual details of the submitted work. *Id.* at 246. The court reminded the Office that a distinguishable variation in the arrangement and manner of presentation of public domain elements was entitled to copyright protection, *Id.* at 246, that the vast majority of works make the copyright grade, and that it is not the Office's task "to shape the protection threshold or

ratchet it up beyond the 'minimal creative spark required by the Copyright Act and the Constitution.'" *Id.* at 247 (quoting *Feist*, 499 U.S. at 363). The Office's assertion of "entirely typical" is the same talismanic type reasoning that the D.C. Circuit rejected in its post-*Feist* holding in *Oman*, 979 F.2d 246 – 47. The Fourth Circuit's deference to the Office's conclusory review of Darden's map elements in combination cannot be reconciled with the D.C. Circuit's holdings requiring the Office to articulate the standard it used for finding a combination of elements lacked sufficient originality.

**3. The Fourth Circuit erred as a matter of law by holding that marketplace acknowledgement of the uniqueness of Darden's maps is irrelevant to the issue of copyright originality.**

The Fourth Circuit affirmed the Office's refusal to take into account evidence that consumers recognized Darden's maps when used by others, that others asked Darden to license the use of his maps, and that competitors removed his maps from their websites when asked. (R. 92 – 93; A. 19a – 20a.) The Fourth Circuit state that third party association of the maps with Darden "is an indication of commercial success over time, not originality." (A. 19a – 20a.) The Fourth Circuit's reasoning fails scrutiny as it asserts that recognition of an image in commerce can only be attributable to commercial success over time, or in trademark terms, acquired commercial strength. In support of its holding, the Fourth Circuit relied upon the Court's holding in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763,

768 – 69 (1992). That portion of the holding established that there exists two basis for evaluating the strength of trade dress: inherent distinctiveness and acquired distinctiveness. The holding does not discuss whether or to what extent these principals may overlap with issues relevant to copyright. The Fourth Circuit held, without any explanation, that recognition of Darden's maps was attributable to "commercial success over time," meaning attributable to "acquired commercial strength" and not due to anything inherently distinctive about the maps.

Mr. Darden's maps are used on websites to help people find appraisers in certain geographic areas. There is nothing remarkable or even noteworthy about using maps on the internet to represent geographic areas. Regardless, there is something distinct enough about Mr. Darden's maps that people recognize the maps as belonging to Mr. Darden when they see the maps on another website being used for this ordinary function. The fact that consumers recognize Mr. Darden's maps provides compelling evidence that these consumers find Mr. Darden's maps distinguishable and recognizable.

The evidence of marketplace recognition rebuts the Office's claim that Mr. Darden's maps contained insignificant variations from the public domain works. (R. 74.) If the difference between Darden's maps and the public domain maps were insignificant, one would not expect to find third parties readily identifying Darden's maps on third party websites. In the context of *Feist*, one would not expect consumers to recognize a copy of

telephone listings as originating from one publisher versus another. In the context of *Oman*, to this day people recognize the BREAKOUT images.

This evidence of third parties recognizing Darden's maps demonstrates that the artistic contributions to the maps were not trivial, but instead they make the maps a distinguishable variation from the prior work. As derivative works distinguishable from the previous works, Mr. Darden's maps are copyrightable. *See Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102 – 03 (2d Cir. 1951) ("All that is needed ... is that the 'author' contributed something more than a 'merely trivial' variation"); *Gerlach-Barklow Co. v. Morris & Bendien, Inc.*, 23 F.3d 159, 161 (2d Cir. 1927) ("While a copy of something in the public domain will not, if it be merely a copy, support a copyright, a distinguishable variation will"); *Imperial Laces Inc. v. Westchester Lace Inc.*, 1998 WL 830630 (S.D.N.Y. Nov. 30, 1998) (finding valid copyright in derivative lace pattern) (R. 434 – 36.); *Godinger Silver Art Co. v. International Silver Co.*, 1995 WL 702357 (S.D.N.Y. Nov. 28, 1995) (finding derivative silver pattern to be protectible as it was not a "mere translation") (R. 437 – 40.) The Fourth Circuit's holding that public recognition of the distinctiveness of a design is not relevant to the issue of "originality" creates an artificial and improper barrier between trademark and copyright evidence.

## CONCLUSION

This matter presents important and converging questions of intellectual property, administrative, and constitutional law. Unlike many cases in these areas, the record in this case is concise and clear, and the facts largely uncontested.

A constitutionally established property right has been denied a citizen of the United States by trial and appellate courts refusing to review *de novo* a constitutional standard. William Darden created a map and was denied copyright protection by the Copyright Office for failure to meet the originality requirement. The originality standard did not originate with Congress or the Copyright Office. Rather, originality is a constitutional standard. Here both the trial court and the appellate court held that Mr. Darden did not have a right of *de novo* review. Instead, on this constitutional standard both courts deferred to the Copyright Office's holding and reviewed the originality requirement under an abuse of discretion review.

The Supreme Court in *Feist* and other cases determined the constitutional standard for copyrightability. It is very minimal. Originality is most often met if the work is simply not a copy of someone else's work. The Copyright Office, in its bureaucratic setting, formulates highly mechanical and rigid requirements for originality that, in practice, surpass the constitutional standard as defined by the Court. In addition to this, applying these rigid tests that have nothing much to do with the standard of originality as articulated by the

Court based on a constitutional analysis, gives rise to subjective evaluations by personnel in the Copyright Office. This framework for testing originality in the Copyright Office is ripe for abuse. A standard of review based on an abuse of discretion will not provide appropriate constitutional review.

The import of this decision extends beyond Mr. Darden. The rise of intangible assets in this country only continues to increase. From e-commerce to entertainment to software, and throughout most areas of business and academia, copyright provides a foundation for the modern economy and information age. Arguably, the ease of copying outpaces the recent increase in the prominence of copyright. The Copyright Office stands at the gateway for regulating the registration and thus the enforcement and management of copyright. This case clarifies the nature of what constitutes copyright, the extent to which the courts must defer to the Copyright Office's determination of what satisfies the constitutional requirement of "originality" and what duty the Copyright Office has in evaluating derivative works. These questions are important to all parties that produce and want to protect copyrightable content. The Fourth Circuit's opinion fails to hold accountable a most important regulatory agency and strongly conflicts with the precedent of this Court and the D.C. Circuit on fundamental issues of copyright. Already, commentators are citing the Fourth Circuit and repeating its erroneous holding. Darden respectfully prays for the granting of a writ so that these arguments may be heard and addressed by the Court.

Respectfully submitted this the 22nd day of October, 2007,

By: /s/ Anthony J. Biller
Anthony J. Biller
Coats & Bennett, PLLC
1400 Crescent Green, Suite 300
Cary, NC 27518
abiller@coatsandbennett.com
Phone No.: (919) 854 – 1844

ATTORNEY FOR PETITIONER

## Table of Contents

**Appendix Page**

Opinion of
The United States Court of Appeals
For the Fourth Circuit
entered May 24, 2007 ..... 1a

Order of
The United States District Court
For the Eastern District of North Carolina
entered December 6, 2005 ..... 22a

Order of
The United States Court of Appeals
For the Second Circuit
Re: Denying Petition for Rehearing
entered July 23, 2007 ..... 35a

U.S. CONST. art. I, § 8, cl. 8 ..... 36a

5 U.S.C. § 702 ..... 37a

5 U.S.C. § 703 ..... 38a

5 U.S.C. § 706 ..... 38a

17 U.S.C. § 102 ..... 39a

17 U.S.C. § 103 ..... 40a

17 U.S.C. § 410 ..... 41a

17 U.S.C. § 411 ..... 42a

17 U.S.C. § 412 ..... 43a

17 U.S.C. § 701 ..... 44a

28 U.S.C. § 1338(a) ..... 46a

37 C.F.R. § 302.1 ..... 47a

Petition for Rehearing
filed July 6, 2007 ..... 48a

Map of Alaska
undated ..... 57a

**[ENTERED: MAY 24, 2007]**

**PUBLISHED**
**UNITED STATES COURT OF APPEALS**
**FOR THE FOURTH CIRCUIT**

WILLIAM DARDEN,
*Plaintiff-Appellant,*

v. No. 06-1177

MARYBETH PETERS, Register of Copyrights,
*Defendant-Appellee.*

Appeal from the United States District Court
for the Eastern District of North Carolina,
at Raleigh.
Terrence W. Boyle, District Judge.
(2:04-cv-00030-BO)

Argued: February 1, 2007

Decided: May 24, 2007

Before WIDENER, TRAXLER, and DUNCAN, Circuit Judges.

Affirmed by published opinion. Judge Traxler wrote the opinion, in which Judge Widener and Judge Duncan joined.

**COUNSEL**

**ARGUED:** Anthony J. Biller, COATS & BENNETT, P.L.L.C., Cary, North Carolina, for Appellant. John

J. Fargo, Director, Intellectual Property Staff, Civil Division, UNITED STATES DEPARTMENT OF JUSTICE, Washington, D.C., for Appellee. **ON BRIEF:** David E. Bennett, COATS & BENNETT, P.L.L.C., Cary, North Carolina, for Appellant. David Carson, General Counsel, Tanya Sandros, Associate General Counsel, A. Renee Coe, Senior Attorney, UNITED STATES COPYRIGHT OFFICE, Washington, D.C.; Peter D. Keisler, Assistant Attorney General, UNITED STATES DEPARTMENT OF JUSTICE, Washington, D.C., for Appellee.

## OPINION

TRAXLER, Circuit Judge:

William Darden filed this action under the Administrative Procedure Act against Marybeth Peters, Register of Copyrights, seeking to set aside a decision of the United States Copyright Office denying Darden's applications for copyright registration. *See* 5 U.S.C. § 706(2)(A); 17 U.S.C. § 701(e). Finding no abuse of discretion in the Register's refusal to issue a copyright registration for Darden's works, we affirm the district court's grant of summary judgment to the Register.

### I.

Darden created a website called "appraisers.com," an online referral service for consumers to locate real estate appraisers throughout the United States. The website features a series of maps that enable a user to find an

appraiser in a desired location by pointing to and clicking on the appropriate map. The homepage of appraisers.com features a stylized map of the United States that serves as a link to a separate page displaying a detailed map of any state selected by the user. The state maps, in turn, are divided into counties; the consumer can retrieve a list of local appraisers by selecting the appropriate county.

In developing his website, Darden hired Sean Pecor, a web designer, to create the maps. Pecor started with a digital Census map of the United States, colored the map blue, and added shading to give the map a three-dimensional effect. Pecor selected a font to use in labeling the states, and he added call-out labels as well. Pecor used the same process for the individual maps of each state. After completing the project, Pecor assigned Darden any copyright interest he held in the maps and the design of the website.

In May 2002, Darden filed an application with the Copyright Office seeking to register his *website*, which he titled "APPRAISERS dotCOM" for purposes of the application, as a technical drawing. Darden described APPRAISERSdotCOM as a derivative work based on "US Census black and white outline maps" and "clip art." J.A. 125. Darden's application identified "graphics, text, colors, and arrangement" as the material that he added to the preexisting work and in which he claimed copyright protection. J.A. 125. Additionally, Darden filed a separate application for registration of the work "Maps for APPRAISERSdotCOM." J.A. 286. Darden described his "Maps" work as a

derivative work that, similar to the "APPRAISERSdot COM" work, was based on preexisting "US Census black and white outline maps." J.A. 287. He claimed copyright ownership in the additions made by Pecor to the preexisting census maps: "font and color selection; visual effects such as relief, shadowing, and shading; labeling; call-outs." J.A. 287.

The Examining Division of the Copyright Office rejected both applications. With respect to Darden's claim in the Maps themselves, the examiner concluded that the work "lack[ed] the authorship necessary to support a copyright claim." J.A. 119. The examiner explained that "[i]n order to be copyrightable, a work of the visual arts must contain a minimum amount of pictorial, graphic, or sculptural authorship" and that "[c]opyright does not protect familiar shapes, symbols, and designs . . . [or] mere variations of typographic ornamentation, lettering, fonts, or coloring." J.A. 119. The labeling, relief, shadowing and shading that Darden contributed to the preexisting maps, the examiner concluded, are standard elements that do not contain copyrightable authorship.

As for Darden's application to register his APPRAISERSdotCOM web pages as a technical drawing, the examiner first noted that the work "does not appear to contain any technical drawing." J.A. 120. Regarding Darden's claim for "graphics," the examiner determined that "[a]ll of the graphic elements appear to consist only of the preexisting outline maps and some simple colored rectangles" and thus the added material was not sufficiently

original to warrant copyright protection. J.A. 120. Darden's variations in color were rejected on the same basis. The examiner observed, however, that "[t]he work contains text and perhaps a compilation which can support a copyright claim, if they are original" and indicated that Darden could pursue registration of an original compilation by filing a new or amended application that "omitt[ed] any reference to 'technical drawing,' 'graphics,' or 'colors.'" J.A. 120.

Darden sought reconsideration by the Examining Division of the Copyright Office. With respect to his application for registration of the Maps work, Darden argued that the maps had a sufficient level of creativity to warrant copyright protection because of "the special combination of font and color selection; visual effects such as relief, shadowing, and shading; labeling; and call-outs. The information the maps convey could easily be provided in other ways; thus, the author should be allowed to protect his creative efforts." J.A. 100. In support of his request for reconsideration, Darden submitted a written "declaration" from Sean Pecor who asserted that, even though he used preexisting census maps as the basis of his work, "each map was altered to such a degree that each line on each map is measurably changed from the digital originals . . . obtained from the US Census." J.A. 116. Specifically, Pecor "resized the maps and redrew many of the antialiased lines" so that "during scale down of [the maps], [the images would not] get a 'chunky' look."

J.A. 116.[1] Pecor claims he also "created a three-dimensional effect by repeating each outline several times — one bright blue outline slightly askew, one darker outline slightly askew, etc." J.A. 116.

Darden submitted an amended application for registration of the APPRAISERSdotCOM work. The revised application indicated that the nature of authorship was a "compilation and arrangement of maps, text, graphics, and data" as opposed to a technical drawing as indicated in the original application. J.A. 107. Darden described the new material in which he claimed copyright as "[t]ext; map designs and formats; compilation, formating, and arrangement of text, maps, graphics, and listing data." J.A. 108. Darden made clear that he was asserting no claim in "the content of the listing data." J.A. 108.

The Examining Division denied Darden's request for reconsideration and registration of his copyright claims. The examining attorney explained that

> [i]n the case of a derivative work, copyright protection covers only the additions or changes appearing in the work for the first time . . . mean[ing] that the new material must contain a sufficient amount of original and creative authorship to be copyrightable. Copyright does not extend to any preexisting or previously registered

---

[1] According to Pecor, "[a]n anti-aliased line is a line digitally softened by a graphic program to render a line more smoothly." J.A. 116.

> material. . . . [W]here the new material consists solely of the uncopyrightable elements such as a change of layout, format, size, spacing or coloring, registration is not possible.

J.A. 94. The examiner concluded that the changes made to Darden's maps work "amount[ed] primarily to layout and format as well as de minimis compilation" and therefore lacked "a sufficient amount of originality and creativity to support a copyright registration." J.A. 97- 98. With respect to the APPRAISERSdotCOM work, the examiner again suggested the possibility of a registrable claim "in only the 'text and compilation of data'" but indicated that a new application, revised to limit the claim to "'text and compilation of data,'" was required. J.A. 98.

Darden then sought review of the denial of his applications by the Copyright Office Board of Appeals. Darden's argument was essentially identical to that asserted in his request for reconsideration:

> Mr. Darden is not seeking a copyright on one particular design element of the maps in question, nor is he asking for protection of "simple combinations" of elements such as "familiar shapes, symbols, and designs; mere variations of typographic ornamentation, lettering, fonts or coloring." Mr. Darden requests protection for the overall pictorial expressions of his maps.

> Mr. Darden's overall design, his special combination of font and color selection, selection and arrangement of geographic locations such as counties, visual effects such as relief, shadowing, and shading, labeling, and call-outs provide the "creative spark" that make[s] the maps original and eligible for protection.

J.A. 87. Darden also presented his own declaration in which he stated that he had "received calls from people and companies asking whether I would license our maps for them to use on their web sites . . . [demonstrating that] people recognize the maps as being unique and proprietary to us." J.A. 92.

The Board of Appeals again affirmed the denial of registration for both the Maps and the APPRAISERSdotCOM works. With regard to the copyright claim in the maps themselves, the Board concluded, as did the Examining Division, that the maps were merely "representations of the preexisting census maps in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent." J.A. 74 (internal quotation marks omitted). The Board also noted that any marketplace confusion created by the use of Darden's maps by third parties was irrelevant to the question of whether the maps were copyrightable, as were requests to Darden by website browsers for license to use the maps. As for the APPRAISERSdotCOM application, the Board of Appeals affirmed the denial of registration "due to the expansive scope of the claim." J.A. 76. Although the Board of Appeals

endorsed the notion that there could well be copyrightable elements included on the website, Darden's claim as stated in his registration application — for "text, maps, and formatting of an Internet web page" — was simply "too broad" to warrant protection. J.A. 76.

Darden then brought this action against the Register of Copyrights under the Administrative Procedure Act ("APA"), *see* 5 U.S.C. §§ 701-706, seeking judicial review of the decision of the Copyright Office refusing to register his copyright claim. Rejecting Darden's argument that the decision of the Copyright Office is subject to a *de novo* standard of review, the district court concluded that the Copyright Office did not abuse its discretion in refusing registration, *see* 5 U.S.C. § 706(2)(A), and granted the Register's motion for summary judgment.

II.

The Copyright Act provides that "all actions taken by the Register of Copyrights under this title are subject to the provisions of the Administrative Procedure Act." 17 U.S.C. § 701(e).[2] One routine function of the Register is to examine applications for registration to determine if "the material deposited constitutes copyrightable subject matter

---

[2] The Copyright Act excepts the Register's performance of a single function from APA review: authorization of, or refusal to authorize, copies or reproductions of "deposited articles retained under the control of the Copyright Office." 17 U.S.C. § 706(b); *see* 17 U.S.C. § 701(e). This narrow exception is not at issue here.

and . . . the other legal and formal requirements of [the Copyright Act] have been met." 17 U.S.C. § 410(a). If so, then the Register must issue a certificate of registration to the applicant, *see* 17 U.S.C. § 410(a); if, however, the Register determines that "the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason," then the Register must refuse registration and notify the applicant of the reasons for refusal, 17 U.S.C. § 410(b). Because the Register's denial of a copyright registration application is, by the statute's plain terms, an action taken by the Register under the Copyright Act, the APA governs judicial review. *See* 17 U.S.C. § 701(e); *Atari Games Corp. v. Oman*, 888 F.2d 878, 879 & n.1 (D.C. Cir. 1989) ("*Atari I*"); *Nova Stylings, Inc. v. Ladd*, 695 F.2d 1179, 1182 (9th Cir. 1983).

The district court concluded that the proper standard of review under the APA is the familiar "abuse of discretion" standard whereby a reviewing court will "set aside agency action, findings, and conclusions" that are "arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law." 5 U.S.C. § 706(2)(A). This is consistent with the few federal decisions — most of which were issued by the same court — addressing the proper review standard under the APA for courts directly reviewing a registration decision. *See Atari Games Corp. v. Oman*, 979 F.2d 242, 243 (D.C. Cir. 1992) ("*Atari II*"); *OddzOn Prods., Inc. v. Oman*, 924 F.2d 346, 347-48 (D.C. Cir. 1991); *Atari I*, 888 F.2d at 881; *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 497 (S.D.N.Y. 2005). *See generally* 3 Melville B. Nimmer

& David Nimmer, *Nimmer on Copyright* § 12.11[B][3], at 12-208 (2005).

Darden does not contest the general applicability of the APA to his claim; indeed, he expressly brought this action under the APA. Darden contends, however, that the district court incorrectly applied the abuse of discretion standard set forth in section 706(2)(A) of the APA. Darden suggests instead that section 706(2)(B) applies to a challenge of the Register's denial of a copyright registration application and mandates a *de novo* standard of review. Section 706(2)(B) directs that the reviewing court set aside agency actions the court finds to be "contrary to constitutional right, power, privilege, or immunity." 5 U.S.C. § 706(2)(B). Under the APA, constitutional questions that arise during APA review fall expressly within the domain of the courts. *See* 5 U.S.C. § 706 (requiring that "[t]o the extent necessary to decision and when presented, the reviewing court *shall* . . . interpret constitutional and statutory provisions") (emphasis added). Thus, judicial review of a claim that the agency's actions violated a claimant's constitutional rights is conducted *de novo*. *See Western Energy Co. v. United States Dep't of Interior*, 932 F.2d 807, 809 (9th Cir. 1991).

Darden cites no authority even remotely suggesting that any court has ever regarded the agency's routine decision to deny registration as having constitutional ramifications for the claimant. Darden derives the basis for his argument from Article I of the United States Constitution which grants Congress the power to provide copyright

protection to the extent Congress sees fit. *See* U.S. Const. Art. I, § 8, cl. 8 (granting Congress legislative power "[t]o promote the Progress of Science and useful Arts, by securing . . . to Authors and Inventors the exclusive Right to their respective Writings and Discoveries"). Congress is under no mandate from this clause, however, to provide copyright protection. *See Silvers v. Sony Pictures Entertainment, Inc.*, 402 F.3d 881, 883 (9th Cir. 2005) ("As is clear from its text, that clause of the Constitution grants no substantive protections to authors. Rather, Congress is empowered to provide copyright protection."). Copyright is solely a creature of statute; whatever rights and remedies exist do so only because Congress provided them. *See Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 431 (1984). Thus, as there is no constitutional right to copyright registration, the Register's refusal to register Darden's claim cannot be "contrary to constitutional right" as it must be for section 706(2)(B) to apply.

Darden next contends that because the Register's decision was based on the agency's incorrect resolution of a legal question, *i.e.*, whether Darden's claim lacked sufficient originality to be registrable, the Register's decision is subject to *de novo* review. More particularly, Darden argues that the Register's refusal to find sufficient originality in his submitted works despite the "extremely low" amount of creativity required for a work to be copyrightable, *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991), was an erroneous conclusion that must be set aside under the "not in accordance with law" provision of section

706(2)(A) of the APA. Additionally, Darden cites various decisions noting, in the context of copyright *infringement* litigation, "that copyrightability is always an issue of law" for the court. *Gaiman v. McFarlane*, 360 F.3d 644, 648 (7th Cir. 2004); *see Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 34 n.5 (1st Cir. 2001); *Collezione Europa U.S.A. v. Hillsdale House*, 243 F.Supp.2d 444, 452 (M.D.N.C. 2003).

We reject Darden's argument. Essentially, Darden is claiming that the Register simply reached the wrong result, not that the Register applied the wrong legal standard or misapprehended or ignored the controlling legal principles. *See Turgeau v. Administrative Review Bd.*, 446 F.3d 1052, 1057 (10th Cir. 2006) (explaining that under § 706(2)(A) "[f]ailure to apply the correct legal standard or to provide this court with a sufficient basis to determine that appropriate legal principles have been followed is grounds for reversal") (internal quotation marks omitted). Review under section 706(2)(A) is "narrow" and the reviewing court is not permitted to substitute its own judgment for the judgment of the agency. *Motor Vehicle Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43 (1983). Rather, the court is to determine "whether the decision was based on a consideration of the relevant factors," *West Virginia v. Thompson*, 475 F.3d 204, 212 (4th Cir. 2007) (quoting *Citizens to Preserve Overton Park, Inc. v. Volpe*, 401 U.S. 402, 416 (1971)), or whether "the agency has relied on factors which Congress has not intended it to consider, [or] entirely failed to consider an important

aspect of the problem," *Motor Vehicle Mfrs.*, 463 U.S. at 43; *see Thompson*, 475 F.3d at 212.

Darden makes no assertion of this kind here; he merely argues that the agency should have concluded that the Maps and APPRAISERS dotCOM works contained the requisite level of creativity, citing *Feist* and other precedents. At every level of internal agency review, however, the Copyright Office recognized *Feist* as having established the contours of the originality element of a copyright claim. Because Darden has failed to identify any relevant factor or legal principle that the Register failed to consider, the agency's decision cannot be set aside as "contrary to law."

Finally, Darden argues that the Register's determination that a copyright claim lacked sufficient originality to warrant registration is subject to *de novo* review in the context of an infringement action under section 411(a) of the Copyright Act. He contends that *de novo* review of the copyrightability issue should also apply in the context of APA review for the sake of efficiency and predictability. We cannot agree.

Congress has afforded disappointed copyright applicants two separate methods of seeking redress for the decision of the Copyright Office not to register a copyright claim. First, as we explained previously, the applicant may file a review action under the APA against the Register of Copyrights for the sole purpose of having the denial of registration set aside. *See* 17 U.S.C. §§ 410(a), 701(e). Darden's action, of course, is such a case. Second, the claimant

may seek judicial review of the rejected registration as part of an infringement action against an alleged infringer under section 411(a) of the Copyright Act.[3]

Both kinds of actions involve, to one degree or another, consideration of whether a copyrightable claim has been presented. The Register has a statutory duty to examine applications for registration to determine if "the material deposited constitutes copyrightable subject matter and . . . the other legal and formal requirements of [the Copyright Act] have been met." 17 U.S.C. § 410(a). Whether the Register issues the certificate of registration or not, the Register necessarily makes a determination about the validity of the copyright claim. And, with respect to a copyright infringement action, the plaintiff must establish "ownership of a valid copyright and copying of constituent elements of the work that are copyrightable." *Compaq Computer Corp. v. Ergonome Inc.*, 387 F.3d 404, 407 (5th Cir. 2004) (internal quotation marks omitted). Copyright ownership, in turn, requires "proof of originality and copyrightability." *Id.* at 408; *see Fiest*, 499 U.S. at 361.

Darden's argument notwithstanding, it is not a foregone conclusion that courts owe no deference

---

[3] Registration is a prerequisite for a copyright infringement action. *See* 17 U.S.C. § 411(a). However, if "the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute an action for infringement if notice . . . is served on the Register of Copyrights" who "may, at his or her option, become a party to the action with respect to . . . registrability of the copyright claim." *Id.*

whatsoever to the Register's decision in the context of an infringement action under section 411(a). Indeed, courts are split on this issue. *Compare John Muller & Co. v. New York Arrows Soccer Team*, 802 F.2d 989, 990 (8th Cir. 1986) (applying abuse of discretion standard to infringement claim); *Norris Indus. v. IT&T Corp.*, 696 F.2d 918, 922 (11th Cir. 1983) (same), *with Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 414 (2d Cir. 1985) (according no deference to Register's copyrightability conclusion); *OddzOn Prods.*, 924 F.2d at 347-50 (same). We need not weigh in on this issue, however, as Darden brought this action against the Register under the APA seeking review of the denial of registration for insufficient originality in his works. Even if no deference is due to the Register's decision by courts adjudicating infringement actions under section 411(a), we must apply the standards set forth in the APA. To do otherwise would be to ignore the clear and unambiguous language of the statute, which we cannot do. Accordingly, we review the decision to register Darden's works for abuse of discretion.

III.

Darden next contends that even if the Register's decision is reviewed under a discretionary standard, it must be set aside because his Maps and APPRAISERSdotCOM works met the minimum standard of originality required for a copyrightable claim. Again, we disagree.

The Copyright Act affords copyright protection for "original works of authorship fixed in any

tangible medium of expression," including "pictoral, graphic, and sculptural works." 17 U.S.C. § 102(a)(5). A work must be original to be copyrightable; indeed, the "*sine qua non* of copyright is originality." *Feist*, 499 U.S. at 345. To be "original," the work in question must have been "independently created by the author (as opposed to copied from other works)," and it must "possess[ ] at least some minimal degree of creativity." *Id.* The threshold level of creativity required for copyrightability is low such that the "vast majority of works make the grade quite easily, as they possess some creative spark." *Id.* Nevertheless, "[t]here remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.* at 359. The Copyright Office established a regulation providing examples of the types of works that fall into the category of works that lack a minimum level of creativity and do not qualify for copyright protection, including "[w]ords and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents." 37 C.F.R. § 202.1(a).

The originality requirement applies to derivative works as well. *See* 17 U.S.C. § 101 (defining derivative work as a work "based upon one or more preexisting works"). The author's copyright protection in a "derivative work only extends to the elements that he has added to the work." *Dam Things from Denmark v. Russ Berrie & Co.*, 290 F.3d 548, 563 (3d Cir. 2002). And, the author's

contributions must satisfy the originality requirement. *See Feist*, 499 U.S. at 359.

A.

We first consider the refusal of the Copyright Office to register Darden's Maps work. In each of the three letters denying registration, the Copyright Office explained that the changes and additions Darden made to the standard census maps in his Maps work claim were uncopyrightable elements that were insufficiently original or creative to be copyrightable. *See Satava v. Lowry*, 323 F.3d 805, 812 n.5 (9th Cir. 2003) (noting that "expressions that are standard, stock, or common to a particular subject matter or medium are not protectable under copyright law"). Additions to the preexisting maps such as color, shading, and labels using standard fonts and shapes fall within the narrow category of works that lack even a minimum level of creativity; indeed, Darden's contributions to the preexisting maps resemble the list of examples of uncopyrightable works set forth in 37 C.F.R. § 202.1(a).

Darden points out that courts have recognized that maps have "have an inherent pictorial or photographic nature that merits copyright protection." *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 142 (5th Cir. 1992); *see Streetwise Maps, Inc. v. Vandam, Inc.*, 159 F.3d 739 (2d Cir. 1998). The general proposition that maps are categorically eligible for copyright registration, however, does not

establish that the maps at issue here are copyrightable.[4]

Darden also argues that the Copyright Office abused its discretion by failing to credit evidence showing that real estate appraisers, other real estate companies, and Darden's customers associate these particular maps with Darden's company. For example, Darden has "received phone calls from people and companies asking whether [he] would license [the] maps for them to use." J.A. 92. And, Darden's customers have reported confusion after encountering a competitor's website that had downloaded Darden's maps. Recognizing the maps, the customers believed that Darden operated the competitor's website. Darden asserts that this evidence of association demonstrates that the maps were unique, creative and original.

We disagree. Source identification is the hallmark of trademark law, not copyright. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768-69 (1992). Furthermore, a work is copyrightable at the time of its creation or not at all. Evidence that customers associated the work with Darden is an

---

[4] The decisions Darden relies upon do not assist him. For instance, *Streetwise Maps* discusses the pictorial elements used, such as color, in the context of an infringement claim — not an examination of copyrightability for purposes of registration. *See Streetwise Maps*, 159 F.3d at 746-48. *Mason*, unlike this case, involved the addition of more than simple colors and labels to a preexisting map. Mason, for example, depicted "the location, size, and shape of surveys, land grants, tracts, and various topographical features" on a county map produced by the United States Geological Survey." *Mason*, 967 F.2d at 136.

indication of commercial success over time, not originality. *See Paul Morelli Design, Inc. v. Tiffany & Co.*, 200 F. Supp. 2d 482, 487-89 (E.D. Pa. 2002).

We conclude that the Register properly refused to register Darden's Maps work. Because there was no abuse of discretion, we decline to set aside the decision of the Copyright Office.

B.

With respect to the APPRAISERSdotCOM work, Darden argues that the Register should have granted his application to copyright his website as a compilation. The Copyright Act defines a compilation as a "work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101. *Feist* instructs that, where a copyright is sought in a compilation, "the principal focus should be on whether the selection, coordination, and arrangement are sufficiently original to merit protection." 499 U.S. at 358.

Darden's revised application indicated that he was claiming protection in the website's "text; map designs and formats; compilation, formatting, and arrangement of text, maps, graphics, and listing data." J.A. 108. In rejecting Darden's claim, the Copyright Office noted that a website may well contain copyrightable elements, but its formatting and layout is not registrable. Compilation authorship is limited to the *original* selection,

coordination and arrangement of the elements or data contained within a work. *See Satava*, 323 F.3d at 812.

We conclude that the Copyright Office acted well within its discretion in concluding that Darden failed to present a copyrightable compilation.

IV.

For the foregoing reasons, we conclude that the Copyright Office did not abuse its discretion in rejecting Darden's application for registration of his Maps and APPRAISERSdotCOM works. Accordingly, we affirm the order of the district court granting the Register's motion for summary judgment and denying Darden's cross-motion for summary judgment.

*AFFIRMED*

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF
NORTH CAROLINA
NORTHERN DIVISION**

No. 2:04-CV-30-BO(1)

WILLIAM DARDEN,

Plaintiff,

v. ORDER

MARYBETH PETERS,
REGISTER OF COPYRIGHTS,

Defendant.

This matter is before the Court on the parties' cross motions for summary judgment. Plaintiff William Darden brings this action pursuant to the Administrative Procedures Act ("APA"), 5 U.S.C. §§ 701-706, seeking review of an adverse decision by Defendant Marybeth Peters, Register of Copyrights ("Register" or "Copyright Office") denying copyright registration. A hearing on the instant motions was held in Raleigh on June 6, 2005. For the reasons discussed below, Defendant's Motion for Summary Judgment is GRANTED and Plaintiffs Motion for Summary Judgment is DENIED.

## BACKGROUND

In May of 2002, Plaintiff filed two Form VA applications with the Copyright Office. Plaintiff

sought registered copyrights for two separate but related works: (1) Maps for APPRAISERSdotCOM ("Maps"), which consists of a series of maps appearing on Plaintiffs website, and (2) the website itself ("APPRAISERSdotCOM").[1] The website is an online referral service that allows consumers to locate real estate appraisers throughout the United States. The Maps are a series of graphical representations of the United States, and geographical subsets thereof, that provide users with a "point-and-click" application for locating appraisers on the APPRAISERSdotCOM website.

Plaintiffs application was initially examined by Wayne Crist, a Senior Examiner in the Visual Arts Section of the Copyright Office. By letter dated May 30, 2002, Mr. Crist informed Plaintiff that neither of his works were eligible for registration. Mr. Crist determined that the Maps lacked the authorship necessary to support a copyright claim, in part because they were derived from U.S. Census maps in the public domain. According to the examiner, the graphical changes made to the existing census maps were insufficient to establish copyrightable authorship. The Copyright Office twice reconsidered the denial of registration, and both times affirmed Mr. Crist's determination that the Maps were not copyrightable.

The Copyright Office also denied registration for APPRAISERSdotCOM. In his initial application,

---

[1] "APPRAISERSdotCOM" was the name used by Plaintiff and the Copyright Office to refer to Plaintiffs website, found at http://www.appraisers.com (last visited December 1, 2005).

Plaintiff described APPRAISERSdotCOM as a "technical drawing" to which the author had added "graphics, text, colors and arrangement."[2] However, Mr. Crist noted in his letter denying registration that the application for APPRAISERSdotCOM did not appear to contain a technical drawing, and that while Plaintiff possibly had a claim for the website's text and data compilation, Plaintiff could not make a legitimate copyright claim for the website's format, layout or page design.[3]

On July 7, 2004, the Copyright Office, by letter, denied registration in the second appeal. The examiners found that the final application for registration of APPRAISERSdotCOM was too broad: "Specific textual, and perhaps also, graphic or pictorial matter within the web pages may have been selected, coordinated and arranged in such a way that a claim of copyright may be sustained for such a compilation, but this would entail submission of a new application limiting the scope of the claim

---

[2] During the two appeals, Plaintiff made changes to the description of his claim for APPRAISERSdotCOM in an unsuccessful attempt to submit a cognizable claim for authorship.

[3] Mr. Crist also informed Plaintiff that his application was procedurally defective. Plaintiffs submission included computer printouts of the website that were dated May 12, 2002. However, Plaintiff claimed an initial publication date of December 1, 1999. Mr. Crist asked Plaintiff to confirm that the printouts submitted reflected the authorship of the works as of the publication date. Plaintiff later responded that except for changes to the appraiser listings, the website layout had undergone de minimus changes since the claimed publication date.

accordingly." The Copyright Office stated that the denial constituted final agency action on the matter. On September 7,2004, Plaintiff brought this action against Defendant pursuant to the APA, seeking reversal of the Register's decision.

## ANALYSIS

### *Standard of Review*[4]

Congress has expressly vested the Register of Copyrights with the power to determine whether a submission constitutes copyrightable subject matter. 17 U.S.C. § 410(a). The Copyright Act, 17 U.S.C. §§ 101-810, provides that decisions of the Register of Copyrights are subject to review under the APA. 5 U.S.C. § 701(e).

The APA permits reviewing courts to set aside agency decisions found to be "arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law." 5 U.S.C. § 706(2)(A), (E); *Duke Power Co. v. US. Nuclear Regulatory Comm'n*, 770

---

[4] At the Raleigh hearing on June 6, 2005, both parties agreed that this case should be decided on summary judgment. *See Custom Chrome v. Ringer*, 35 U.S.P.Q.2d 1714 (D.D.C. June 30, 1995); *Magic Marketing, Inc. v. Mailing Services of Pittsburgh, Inc.*, 634 F. Supp. 769 (W.D.Pa. 1986). Summary judgment is appropriate if there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(c); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247 (1986). A moving party is entitled to summary judgment when the record, taken as a whole, could not lead a rational trier of fact to find for the non-movant. *See Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986).

F.2d 386, 389 (4th Cir. 1985). The scope of a court's review under the "arbitrary and capricious" standard is narrow. *See Bowman Transp., Inc. v. Arkansas-Best Freight Sys., Inc.*, 419 U.S. 281, 285 (1974). A court should "consider whether the decision was based on a consideration of the relevant factors and whether there has been a clear error of judgment." However, "[t]he court is not empowered to substitute its judgment for that of the agency." *Citizens to Preserve Overton Park, Inc. v. Volpe*, 401 U.S. 402, 416 (1971).

Plaintiff argues that the Register's denial of copyright registration should be reviewed *de novo*. In making such an argument, Plaintiff has erroneously conflated two types of copyright cases: an infringement action and a challenge to an adverse decision of the Copyright Office. In a copyright infringement action, copyrightability is a question of law reserved to the judge and subject to *de novo* review by appellate courts. *See, e.g. Pivot Point Int'l, Inc. v. Charlene Prod., Inc.*, 372 F.3d 913, 919 (7th Cir. 2004); *Collezione Europa U.S.A., Inc. v. Hillsdale House, Ltd.*, 243 F. Supp. 2d 444, 452 (M.D.N.C. 2003). On the other hand, a challenge to an adverse decision by the Register of Copyrights is brought pursuant to the APA, and therefore does not hinge on the copyrightability of the material at issue but on the propriety of the Register's decision.

While not specifically addressed in this circuit, courts deciding the appropriate standard of review have held that the Register of Copyrights is entitled to deference, and have reviewed denials of registration for an abuse of discretion in suits

brought under the APA. *OddzOn Products v. Oman*, 924 F.2d 346, 347 (D.C. Cir. 1991); *Atari Games v. Oman*, 888 F.2d 878, 879 (D.C. Cir. 1989); *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 497 (S.D.N.Y. September 6, 2005); *Custom Chrome v. Ringer*, 35 U.S.P.Q.2d 1714 (D.D.C. June 30, 1995); see also 3 M. Nimmer & D. Nimmer, Nimmer on Copyright § 12.11[B][3] (2005). In such cases, if the Register "intelligibly account[s]" for the decision via "reasoned decision making" then the result will not be upset. *Atari Games*, 888 F.2d at 879. The Register's refusal to register Plaintiffs copyrights will therefore not be reversed absent an abuse of discretion.

***Legal Background***

The Constitution provides that "The Congress shall have the Power ... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const. art. I, § 8, cl. 8. The Copyright Act of 1976 vests the Register of Copyrights with the duty to determine whether material submitted for registration is copyrightable. 17 U.S.C. § 410(a). The Copyright Act defines copyrightable material as "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102. Works of authorship include "pictoral, graphical and sculptural works." 17 U.S.C. § 102(a)(5).

To be copyrightable, a work must be original. 17 U.S.C. § 102(a). Originality is the "*sine qua non*" of copyright. *Feist Pub., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). In *Feist*, the Supreme

Court held that to meet the originality requirement, a work must have been independently created by the author, and must possess at least a minimum degree of creativity. *Id.* at 345. While "the requisite level of creativity is extremely low", there is "a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent. Such works are incapable of sustaining a valid copyright." *Id.* at 345, 349.

Pursuant to its congressionally delegated authority, the Copyright Office has promulgated regulations that apply the Supreme Court's originality requirement. See 17 C.F.R. § 202.1. Items not subject to copyright include "[w]ords and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents." *Id.*

***The Register's Denial of Copyright Registration for the Maps***

In this case, the Copyright Office reviewed Plaintiffs application three times, and each time found that Plaintiffs Maps did not satisfy the originality requirement. Defendant's three rejections of Plaintiffs application evidence a carefully reasoned decision that was within the Register's discretion. In the first letter denying Plaintiffs application, Mr. Crist informed Plaintiff that the visual modifications made to preexisting census maps were insufficient to make the Maps "original." The second denial of Plaintiffs application clarified that in the case of derivative work, "new material

must contain a sufficient amount of original and creative authorship to be copyrightable." The Copyright Office determined that the changes to the census maps noted by Plaintiff-- such as layout, format, size, spacing and coloring--were not registerable. Citing *Feist*, the third denial of Plaintiffs registration stated that the maps were "representations of the preexisting census maps 'in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.'"

The final rejection letter went into great detail concerning the lack of creativity evident in the Maps. The minor changes made to the U.S. Census maps were insufficiently creative. The author used postal abbreviations to identify the 50 states[5]. The author used shading to add minor visual effects. The maps of the individual states were divided by county. The individual state maps are shaded in blue, while the county names are written in white.

The Copyright Office has reasonably determined that certain graphical elements of a work, such as shading, coloring or fonts, are not by themselves sufficient to make a work original. Compendium of Copyright Office Practices II, §305.06. Each of the changes to the existing census maps was in the nature of a shading, coloring or font change. The Register reasonably applied its own internal regulations in concluding that these

---

[5] Plaintiff hired Sean Pecor to design the maps in late 1997. In 1999, Mr. Pecor assigned all copyrights in the Maps to Plaintiff.

elements in the Maps were uncreative and did not render the Maps an original work of authorship.

Plaintiff argues that in focusing on particular elements, the Copyright Office failed to look at the Maps as a whole. However, the Copyright Office expressly noted that it was bound to examine submitted works "as a whole." *Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989). The final denial of Plaintiffs application broadly states that "[i]n this case there is insufficient pictorial or graphic authorship to support registration." The fact that the Copyright Office goes into detail elsewhere is the hallmark of a reasoned decision, not a misapplication of the law. Furthermore, any detailed description of a potentially copyrightable work requires some recital of constituent parts, as is the case here.

Plaintiff also argues, as he did in each of his appeals to the Copyright Office, that Maps are inherently copyrightable.[6] Plaintiff cites a number of cases that found maps to be worthy of copyright protection, including *Mason v. Montgomery Data, Inc.*, 967 F.2d 135 (5th Cir. 1992), and *Streetwise Maps, Inc. v. Vandam, Inc.*, 159 F.3d 739 (2nd Cir. 1998). The Copyright Office correctly found Plaintiffs argument inapposite. The *Mason* decision was an

---

[6] Plaintiff also goes to great lengths to detail the effort put into Mr. Pecor's creation of the Maps. However, any "sweat of the brow" theory of copyright protection that grants protection based on the effort expended on the work, has been firmly rejected. *Feist*, 499 U.S. at 353.

infringement action in which the Fifth Circuit Court of Appeals found that certain maps met the minimum level of creativity required by *Fleist*, based on significant changes made by the author. 967 F.2d at 145. Similarly, in *Streetwise Maps* the Second Circuit Court of Appeals found that a series of maps was made copyrightable as a result of depictions and colors added by the author. 159 F.2d at 748. Both cases represent a conclusion that the particular maps at issue satisfied the originality requirement; they do not imply that the Copyright Office must approve registration of any and all maps.

Because the Register correctly applied the law and carefully considered pertinent factors in determining that the Maps lacked the requisite level of originality, the denial of registration must be upheld.

***The Register's Denial of Copyright Registration for APPRAISERSdotCOM***

The Copyright Office also denied registration for APPRAISERSdotCOM. Ultimately, registration was denied because Plaintiffs application was too broad.[7] Plaintiff initially sought to copyright the

---

[7] In the letter denying Plaintiffs second appeal, the Copyright Office also noted that Plaintiffs registration claim for APPRAISERSdotCOM remained procedurally defective, because it did not include copies of the website as it appeared on the claimed publication date, December 1, 1999. In an earlier letter, Plaintiff had affirmed that the copies of the website were representative of the site on the publication date, because there had been only "de minimus changes" since then. Nevertheless, in the letter denying Plaintiffs second appeal, the Copyright Office noted that the failure to include properly

website's "compilation and arrangement of maps, text, graphics and data," and subsequently amended the claim to seek registration of "text, maps and formatting of an Internet web page." The Copyright Office determined that while there might be copyrightable elements on the APPRAISERSdotCOM website, the scope of Plaintiffs claim for copyright was simply too expansive. The examiners reasoned that because the maps were not copyrightable, the arrangement of the maps on the website was also not copyrightable. Furthermore, the examiners noted that in general, formatting of web pages is not copyrightable.

Plaintiff argues that the Copyright Office erred in failing to grant registration to APPRAISERSdotCOM as a compilation. A compilation is a work "formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101. However, a compilation must be original to obtain protection. *Fleist*, 499 U.S. at 358. "The principal focus should be on whether the selection, coordination, and arrangement are sufficiently original to merit protection. Not every selection, coordination, or arrangement will pass muster." *Id.*

The Copyright Office repeatedly addressed Plaintiffs claim for copyright of APPRAISERSdotCOM as a compilation. Looking at

---

dated materials "appears fatal to such a [copyrightability] claim."

the website as a whole, the examiners concluded that the arrangement of elements lacked even a minimal degree of creativity, and that "protection for the overall format of a web page is inconsistent with copyrightability." In the third denial of Plaintiffs claim, the Copyright Office explained that "[tlhe longstanding practice of the Copyright Office is to deny registration of the arrangement of elements on the basis of physical or directional layout in a given space, whether that space is a sheet of paper or a screen of space meant for information displayed digitally." The examiners also noted that while certain elements of the website might be copyrightable, including the arrangement of data into categories, Plaintiffs request for registration was far too broad since it included a claim for uncopyrightable Maps, unoriginal formatting elements, and an uncreative layout of those elements.

Based on a review of the administrative record, the Copyright Office acted within its discretion in denying registration of APPRAISERSdotCOM as a copyrightable compilation. The agency provided ample factual and legal support for the conclusion that the website arrangement lacked any degree of creativity, and correctly applied controlling precedent on the copyrightability of compilations. Additionally, the Court notes that the Register of Copyrights may demand that submissions comply with reasonable procedures,[8] including requirements that claims for

---

[8] Congress has authorized the Register to "establish regulations not inconsistent with law for the administration of the functions and duties made the responsibility of the

copyright narrowly exclude uncopyrightable elements and that submissions reflect the work as of the claimed publication date. The Copyright Office acts within its discretion when it denies registration on such grounds.

## CONCLUSION

The Court finds that Defendant intelligibly accounted for the denial of Plaintiffs application for copyright registration. For the reasons stated above, Defendant's Motion for Summary Judgment is hereby GRANTED, and Plaintiff's Motion for Summary Judgment is DENIED.

SO ORDERED, this, the 6th day of December 2005.

/s/ Terrence W. Boyle
TERRENCE W. BOYLE
UNITED STATES DISTRICT JUDGE

---

Register." 17 U.S.C. § 702. Pursuant to that authority, the Register has promulgated regulations governing the registration of copyrights. See 17 C.F.R. § 202.3.

**[ENTERED: JULY 23, 2007]**

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

FILED
July 23, 2007

No. 06-1177
2:04-cv-00030-BO

WILLIAM DARDEN

Plaintiff - Appellant

v.

MARYBETH PETERS, Register of Copyrights

Defendant - Appellee

ORDER

Appellant has filed a petition for rehearing.

The Court denies the petition for rehearing.

Entered for a panel composed of Judge Traxler, Judge Duncan, and Senior Judge Widener.

For the Court,

/s/ Patricia S. Connor
CLERK

## U.S. CONST. art. 1, § 8, cl. 8

**Section. 8.**

Clause 8: To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

## 5 U.S.C. § 702

**Section 702. Right of review**

A person suffering legal wrong because of agency action, or adversely affected or aggrieved by agency action within the meaning of a relevant statute, is entitled to judicial review thereof. An action in a court of the United States seeking relief other than money damages and stating a claim that an agency or an officer or employee thereof acted or failed to act in an official capacity or under color of legal authority shall not be dismissed nor relief therein be denied on the ground that it is against the United States or that the United States is an indispensable party. The United States may be named as a defendant in any such action, and a judgment or decree may be entered against the United States: Provided, That any mandatory or injunctive decree shall specify the Federal officer or officers (by name or by title), and their successors in office, personally responsible for compliance. Nothing herein (1) affects other limitations on judicial review or the power or duty of the court to dismiss any action or deny relief on any other appropriate legal or equitable ground; or (2) confers authority to grant relief if any other statute that grants consent to suit expressly or impliedly forbids the relief which is sought.

## 5 U.S.C. § 703

### Section 703. Form and venue of proceeding

The form of proceeding for judicial review is the special statutory review proceeding relevant to the subject matter in a court specified by statute or, in the absence or inadequacy thereof, any applicable form of legal action, including actions for declaratory judgments or writs of prohibitory or mandatory injunction or habeas corpus, in a court of competent jurisdiction. If no special statutory review proceeding is applicable, the action for judicial review may be brought against the United States, the agency by its official title, or the appropriate officer. Except to the extent that prior, adequate, and exclusive opportunity for judicial review is provided by law, agency action is subject to judicial review in civil or criminal proceedings for judicial enforcement.

## 5 U.S.C. § 706

### Section 706. Scope of review

To the extent necessary to decision and when presented, the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of an agency action. The reviewing court shall –

(1) compel agency action unlawfully withheld or unreasonably delayed; and

(2) hold unlawful and set aside agency action, findings, and conclusions found to be -

(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

(B) contrary to constitutional right, power, privilege, or immunity;

(C) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right;

(D) without observance of procedure required by law;

(E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute; or

(F) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court.

In making the foregoing determinations, the court shall review the whole record or those parts of it cited by a party, and due account shall be taken of the rule of prejudicial error.

## 17 U.S.C. § 102

**Section 102. Subject matter of copyright: In general**

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either

directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works;

(2) musical works, including any accompanying words;

(3) dramatic works, including any accompanying music;

(4) pantomimes and choreographic works;

(5) pictorial, graphic, and sculptural works;

(6) motion pictures and other audiovisual works;

(7) sound recordings; and

(8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

## 17 U.S.C. § 103

### Section 103. Subject matter of copyright: Compilations and derivative works

(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

(b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the

preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

## 17 U.S.C. § 410

### Section 410. Registration of claim and issuance of certificate

(a) When, after examination, the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met, the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office. The certificate shall contain the information given in the application, together with the number and effective date of the registration.

(b) In any case in which the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason, the Register shall refuse registration and shall notify the applicant in writing of the reasons for such refusal.

(c) In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary

weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court.

(d) The effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office.

## 17 U.S.C. § 411

**Section 411. Registration and infringement actions**

(a) Except for an action brought for a violation of the rights of the author under section 106A(a), and subject to the provisions of subsection (b), no action for infringement of the copyright in any United States work shall be instituted until registration of the copyright claim has been made in accordance with this title. In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute an action for infringement if notice thereof, with a copy of the complaint, is served on the Register of Copyrights. The Register may, at his or her option, become a party to the action with respect to the issue of registrability of the copyright claim by entering an appearance within sixty days after such service, but the Register's failure to become a party shall not deprive the court of jurisdiction to determine that issue.

(b) In the case of a work consisting of sounds, images, or both, the first fixation of which is made simultaneously with its transmission, the copyright owner may, either before or after such fixation takes place, institute an action for infringement under section 501, fully subject to the remedies provided by sections 502 through 506 and sections 509 and 510, if, in accordance with requirements that the Register of Copyrights shall prescribe by regulation, the copyright owner -

(1) serves notice upon the infringer, not less than 48 hours before such fixation, identifying the work and the specific time and source of its first transmission, and declaring an intention to secure copyright in the work; and

(2) makes registration for the work, if required by subsection (a), within three months after its first transmission.

## 17 U.S.C. § 412

**Section 412. Registration as prerequisite to certain remedies for infringement**

In any action under this title, other than an action brought for a violation of the rights of the author under section 106A(a) or an action instituted under section 411(b), no award of statutory damages or of attorney's fees, as provided by sections 504 and 505, shall be made for -

(1) any infringement of copyright in an unpublished work commenced before the effective date of its registration; or

(2) any infringement of copyright commenced after first publication of the work

and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.

## 17 U.S.C. § 701

**Section 701. The Copyright Office: General responsibilities and organization**

(a) All administrative functions and duties under this title, except as otherwise specified, are the responsibility of the Register of Copyrights as director of the Copyright Office of the Library of Congress. The Register of Copyrights, together with the subordinate officers and employees of the Copyright Office, shall be appointed by the Librarian of Congress, and shall act under the Librarian's general direction and supervision.

(b) In addition to the functions and duties set out elsewhere in this chapter, the Register of Copyrights shall perform the following functions:

(1) Advise Congress on national and international issues relating to copyright, other matters arising under this title, and related matters.

(2) Provide information and assistance to Federal departments and agencies and the Judiciary on national and international issues relating to copyright, other matters arising under this title, and related matters.

(3) Participate in meetings of international intergovernmental organizations and meetings with foreign government officials relating to copyright, other matters arising under this title,

and related matters, including as a member of United States delegations as authorized by the appropriate Executive branch authority.

(4) Conduct studies and programs regarding copyright, other matters arising under this title, and related matters, the administration of the Copyright Office, or any function vested in the Copyright Office by law, including educational programs conducted cooperatively with foreign intellectual property offices and international intergovernmental organizations.

(5) Perform such other functions as Congress may direct, or as may be appropriate in furtherance of the functions and duties specifically set forth in this title.

(c) The Register of Copyrights shall adopt a seal to be used on and after January 1, 1978, to authenticate all certified documents issued by the Copyright Office.

(d) The Register of Copyrights shall make an annual report to the Librarian of Congress of the work and accomplishments of the Copyright Office during the previous fiscal year. The annual report of the Register of Copyrights shall be published separately and as a part of the annual report of the Librarian of Congress.

(e) Except as provided by section 706(b) and the regulations issued thereunder, all actions taken by the Register of Copyrights under this title are subject to the provisions of the Administrative Procedure Act of June 11, 1946, as amended (c. 324, 60 Stat. 237, title 5, United States Code, Chapter 5, Subchapter II and Chapter 7).

(f) The Register of Copyrights shall be compensated at the rate of pay in effect for level III of the Executive Schedule under section 5314 of title 5. The Librarian of Congress shall establish not more than four positions for Associate Registers of Copyrights, in accordance with the recommendations of the Register of Copyrights. The Librarian shall make appointments to such positions after consultation with the Register of Copyrights. Each Associate Register of Copyrights shall be paid at a rate not to exceed the maximum annual rate of basic pay payable for GS-18 of the General Schedule under section 5332 of title 5.

## 28 U.S.C. § 1338(a)

**Section 1338. Patents, plant variety protection, copyrights, mask works, designs, trademarks, and unfair competition**

(a) The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases.

## 37 C.F.R. § 302.1

**Sec. 302.1 Public records and access.**

(a) Inspection. Records of proceedings before the Board will be available for public inspection at the Copyright Royalty Board offices.

(b) Requests. Requests for access to records must be directed to the Copyright Royalty Board. No requests for information or access to records shall be directed to or accepted by a Copyright Royalty Judge. Access to records is only available by appointment.

**THE UNITED STATES COURT OF APPEALS**
**FOR THE FOURTH CIRCUIT**
**Appeal No. 06-1177**

| | | |
|---|---|---|
| **WILLIAM DARDEN,** | ) | |
| **Plaintiff/Appellant,** | ) | |
| | ) | |
| **v.** | ) | **PETITION FOR** |
| | ) | **REHEARING** |
| **MARYBETH PETERS,** | ) | |
| **REGISTER OF** | ) | |
| **COPYRIGHTS,** | ) | |
| **Defendant/Appellee.** | ) | |

Plaintiff-Appellant William Darden petitions the Court to rehear his argument pursuant to Federal Rule of Appellate Procedure 40 and Local Rule 40. In undersigned counsel's judgment, material legal matters were overlooked in the Court's decision of May 24, 2007. Specifically, the Panel did not address (1) whether the Copyright Office's analysis of "originality" addressed what the Constitution recognizes as copyright and is thus subject to review under 15 U.S.C. § 706(2)(B), and (2) whether the Copyright Office committed legal error when it analyzed individual elements of the maps, acknowledged that copyrightability must be determined by looking at the work as a whole, and then simply rejected the works as "entirely typical" without further analysis.

**I. The panel did not address whether the issue of "Originality" presents a question of a constitutional property right subject to review under 15 U.S.C. § 706(2)(B).**

Darden argued that the Copyright Office made an incorrect analysis of constitutional law when it held that Darden's maps lacked originality and thus contained no copyright. The issue is whether the Copyright Office determined the existence (or the lack thereof) of a property right recognized under the Constitution when the Office decided that Darden's works lacked sufficient originality to be registered. Darden asserted that the determination of copyright originality is a question of constitutional property law and subject to de novo review under 15 U.S.C. § 706(2)(B). The Panel did not address this issue.

The Panel misconstrued Darden's § 706(2)(B) argument. The Panel described Darden as arguing that the constitutional right at issue was Darden's right to register his works. Specifically, the Panel stated the argument thusly:

> Darden suggests ... that section 706(2)(B) applies to a challenge of the Register's denial of a copyright registration application and mandates *de novo* standard of review. ...
>
> ...Darden derives the basis for his argument from Article I of the United States Constitution which grants Congress the power to provide copyright protection to the extent

> Congress sees fit. ... Congress is under no mandate from this clause, however, to provide copyright protection. ... Thus, as there is no constitutional right to copyright registration, the Register's refusal to register Darden's claim cannot be "contrary to constitutional right" as it must be for section 706(2)(B) to apply.

[Slip Op. 8-9.] Darden was not, and does not, argue as such.

Darden argues that the Copyright Office's finding of "insufficient originality" was an analysis of whether a particular type of property right exists, i.e., a copyright. In this instance, the property right at issue derives directly from the Constitution's granting Congress the power to protect an author's "writings." The Supreme Court explained, to be protected by copyright, the Constitution requires "writings" to be sufficiently original. The Court further explained that this determination of "[o]riginality is a constitutional requirement." *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 346, 111 S. Ct. 1282, 1288 (1991). It has long been established that the base requirement for copyright is "originality" and that the Constitution mandates this standard. *Id.* at 345-47, 111 S. Ct. at 1287-88; *accord Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 23 S. Ct. 298 (1903); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58, 4 S. Ct. 279 (1884); *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 102-03 (2nd Cir. 1951); *J.L. Mott Iron Works v. Clow*, 82 F. 316 (7th

Cir. 1897). The Copyright Office's analysis of originality presented a question of constitutional law. A copyright is, per se, a right. The Office analyzed whether Darden's maps satisfied the constitutional prerequisites for this right to exist.

As discussed at oral argument, the constitutional "right" at issue in this case relevant to § 706(2)(B) is not an individual right. Darden does not argue he has an individual right under the Constitution to register a copyright. The "right" implicated is a property right, specifically, whether constitutional jurisprudence recognizes Darden's "writings" as sufficiently "original," i.e., whether a copyright exists. The word "right" in § 706(2)(B) is not limited to "individual" rights but involves any right under the Constitution, to include the property right the Constitution recognizes as original writings, which Congress may protect.

In its brief, the Government took the position that courts always afford the Office deference regarding the denial of a registration for lack of copyrightable subject matter. Upon scrutiny, however, there is an important distinction in these cases that the Government's argument overlooked. As the Panel observed, the Constitution empowers Congress to protect copyrights, but it does not require protection. Accordingly, there is no individual "right" to have one's copyright protected if Congress has not extended such protection. Congress decided where and to what extent to extend copyright protection. By doing so, Congress defined subject matter that may and that may not be copyrighted. For example, Congress extended

copyright protection to maps but not to useful articles, i.e., "industrial designs." *See* 17 U.S.C. § 101 (definition for "Pictorial, graphic, and sculptural works"). Congress defined subject matter for which copyright would be afforded. The Copyright Office was left to interpret interpret what these areas of subject matter included.

There has been little dispute regarding what falls within the definition of "map." There has, however, been significant litigation regarding the definition of other copyrightable subject matter under the Copyright Act, such as for "useful articles." *See, e.g., OddzOn Prod., Inc. v. Oman*, 924 F.2d 346 (D.C. Cir. 1991); *Eltra Corp. v. Ringer*, 579 F.2d 294 (4th Cir. 1 978); *Esquire, Inc. v. Ringer*, 591 F.2d 796 (D.C. Cir. 1978). In such litigation, courts afford the Copyright Office discretion in construing the subject matter boundaries set by Congress, such as defining what constitutes a "useful article." There are additional examples of courts addressing how the Office interprets portions of the Copyright Act, many of which can be found in the Government's brief and explained further in Darden's reply. Under current administrative law, courts have appropriately afforded the Copyright Office deference in interpreting the statutory lines and definitions Congress set regarding the extent to which it affords copyright protection.

Darden does not take issue with this line of cases; however, those cases are not on point with the issue at hand. This is not a case contesting how the Copyright Office construed "useful articles," what constituted a "map," or any other statutory line or

limitation set by Congress. There is no dispute that a map is copyrightable subject matter and that Darden submitted maps for registration. This is a case where the Office rested its decision on a finding that Darden's maps lacked sufficient originality. The prerequisite of originality derives from the Constitution.[1]

There is one circuit case, over two holdings, that specifically addresses the standard of review for the Office's denial of registration based on a finding of insufficient originality. *See Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989); *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C. Cir. 1992). In the *Atari* holdings, the court stated it was giving deferential review to the Office's analysis of "originality," but in practice, the court gave no deference. That court twice rejected the Office's proffered analysis of originality. Aside from one concurring opinion, the court gave little explanation why it used a deferential standard of review. The concurring opinion offered a purely pragmatic rationale for that standard. *See Oman*, 888 F.2d at 886-87 (Silberman, J., concurring). That "originality" is a constitutional requirement for copyright was not mentioned, let alone analyzed.

"Originality" is a constitutional pre-requisite for copyright protection. The Constitution imposes the requirement. When the Copyright Office decided

---

[1] "[I]t seems self-evident that Congress could not constitutionally create a lower standard of originality...." Howard B. Abrams, The Law of Copyright § 2:2 (Oct. 2006).

that Darden's works did not exhibit sufficient originality, the Office decided that a requirement imposed by our Constitution had not been satisfied. An incorrect analysis of a constitutional property right is "contrary to constitutional right." [*See* Slip Op. 9.] The courts should not, thus, afford the Copyright Office any deference on the issue of whether the constitutional pre-requisites for obtaining copyright protection have been met. Review should be had under 15 U.S.C. § 706(2)(B). Darden respectfully prays to have this argument heard and addressed by this Panel.

**II. The Panel's opinion did not address Darden's argument that the Copyright Office committed legal error when it simply concluded, without analysis, that the maps taken as a whole were "entirely typical" and thus not copyrightable.**

In its analysis, the Copyright Office reviewed individual elements of Darden's maps, and concluded that each element, in isolation, was not copyrightable. The Office then acknowledged its duty to analyze the elements as a whole, and concluded that the arrangement of these elements is "entirely typical" and did not rise to the level of creative authorship necessary to sustain a copyright. No where in the administrative record, at the District Court, or in its appeal brief did the Government explain why the works when taken as a whole are "entirely typical."

In *Feist* the Court found the works at issue "entirely typical," and dedicated several paragraphs

to explaining the basis for this conclusion. *See Feist*, 499 U.S. 362, 111 S. Ct. 1296. The Government has never tendered such an analysis for Darden's maps nor did the Court address this deficiency in its opinion.

The Office's mere assertion of "entirely typical" is the same talismanic assertion that the District of Columbia Circuit rejected in its post-*Feist* holding in *Oman*, 979 F2d 245- 47. As in *Oman*, the Office does not explain what standard it used for assessing the elements in combination and how the office came to its conclusion on originality. The Office's failure to analyze all of Darden's elements in combination was "not in accordance with law" and should be reviewed de novo under § 706(2)(A) of the APA.

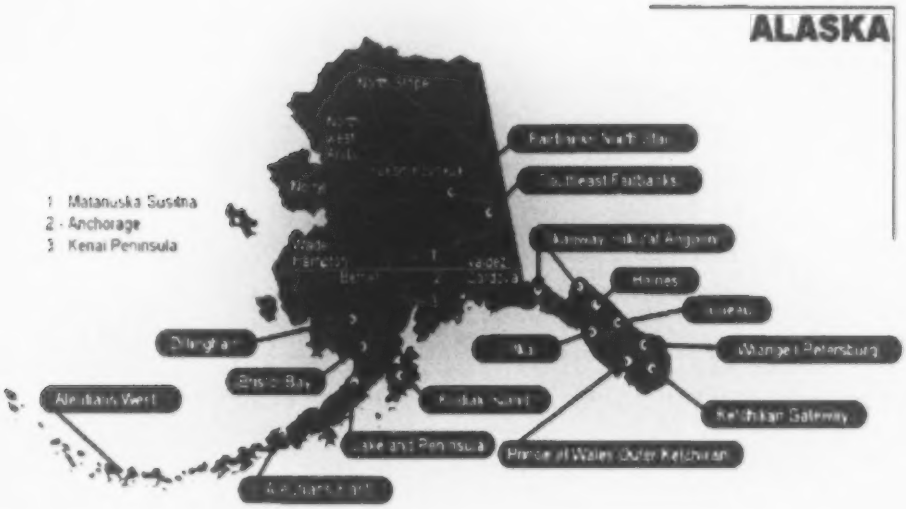
**III. Conclusion**

These are nuanced and somewhat abstract legal arguments that Darden pursued in his briefs and at oral argument. The Panel did not address them in the opinion, and undersigned counsel believes these issues are Darden's two most important legal arguments. After so many years of effort, Darden respectfully prays the Panel to revisit and rehear these arguments.

Respectfully submitted this the 6th day of July, 2007,

By: _____

Anthony J. Biller
Coats & Bennett, PLLC
1400 Crescent Green, Suite 300
Cary, NC 27518
abiller@coatsandbennett.com
Phone No.: (919) 854-1844




BEST AVAILABLE COPY

2

No. 07-527

# In the Supreme Court of the United States

WILLIAM DARDEN, PETITIONER

*v.*

MARYBETH PETERS, REGISTER OF COPYRIGHTS

*ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT*

## BRIEF FOR THE RESPONDENT IN OPPOSITION


PAUL D. CLEMENT
*Solicitor General*
*Counsel of Record*

JEFFREY S. BUCHOLTZ
*Acting Assistant Attorney General*

JOHN J. FARGO
ANTHONY J. STEINMEYER
JOHN S. KOPPEL
*Attorneys*

*Department of Justice*
*Washington, D.C. 20530-0001*
*(202) 514-2217*

TANYA M. SANDROS
*General Counsel*

ROBERT KASUNIC
*Attorney*
*U.S. Copyright Office*
*Washington, D.C. 20559*

## QUESTIONS PRESENTED

Section 410(b) of Title 17 of the United States Code directs the Register of Copyrights (Register) to refuse registration if she determines that the material deposited does not constitute copyrightable subject matter. Section 701(e) makes actions taken by the Register, including refusals of registration, subject to review pursuant to the Administrative Procedure Act (APA), 5 U.S.C. 706(2)(A). The questions presented are:

1. Whether review of the Register's refusal to register petitioner's copyright claims is to be conducted under the APA's abuse-of-discretion standard.

2. Whether the Register acted within her discretion in refusing to register petitioner's claim to copyright in maps of the States of the United States.

## TABLE OF CONTENTS

Page

Opinions below ..... 1
Jurisdiction ..... 1
Statement ..... 1
Argument ..... 5
Conclusion ..... 12

## TABLE OF AUTHORITIES

Cases:

*Atari Games Corp.* v. *Oman*, 979 F.2d 242 (D.C. Cir. 1992) ..... 6, 9, 11
*Atari Games Corp.* v. *Oman*, 888 F.2d 878 (D.C. Cir. 1989) ..... 5, 6
*ATC Distribution Group, Inc.* v. *Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700 (6th Cir. 2005) ..... 11
*Bailie* v. *Fisher*, 258 F.2d 425 (D.C. Cir. 1958) ..... 6
*Bouve* v. *Twentieth Century-Fox Film Corp.*, 122 F.2d 51 (D.C. Cir. 1941) ..... 6
*CMM Cable Rep., Inc.* v. *Ocean Coast Props., Inc.*, 97 F.3d 1504 (1st Cir. 1996) ..... 11
*Carol Barnhart, Inc.* v. *Economy Cover Corp.*, 773 F.3d 411 (2d Cir. 1985) ..... 7
*Coach, Inc.* v. *Peters*, 386 F. Supp. 2d 495 (S.D.N.Y. 2005) ..... 6, 8, 11, 12
*Custom Chrome, Inc.* v. *Ringer*, 35 U.S.P.Q.2d 1714 (D.D.C. 1995) ..... 6
*Dickinson* v. *Zurko*, 527 U.S. 150 (1999) ..... 8

Cases—Continued: Page

*Esquire, Inc.* v. *Ringer*, 591 F.2d 796 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979) ..... 6

*Feist Publ'ns, Inc.* v. *Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) ..... 3, 7, 10

*Goldstein* v. *California*, 412 U.S. 546 (1973) ..... 8

*Homer Laughlin China Co.* v. *Oman*, 22 U.S.P.Q.2d 1074 (D.D.C. 1991) ..... 6, 8

*Jon Woods Fashions, Inc.* v. *Curran*, 8 U.S.P.Q.2d 1870 (S.D.N.Y. 1988) ..... 6

*John Muller & Co., Inc.* v. *New York Arrows Soccer Team, Inc.*, 802 F.2d 989 (8th Cir. 1986) ..... 6, 9

*Norris Indus., Inc.* v. *International Tel. & Tel. Corp.*, 696 F.2d 918 (11th Cir.), cert. denied, 464 U.S. 818 (1983) ..... 6

*Nova Stylings, Inc.* v. *Ladd*, 695 F.2d 1179 (9th Cir. 1983) ..... 5

*OddzOn Prod., Inc.* v. *Oman*, 924 F.2d 346 (D.C. Cir. 1991) ..... 6, 7

*Silvers* v. *Sony Pictures Entm't, Inc.* 402 F.3d 881 (9th Cir.), cert. denied, 546 U.S. 827 (2005) ..... 8

*Sony Corp. of Amer.* v. *Universal City Studios, Inc.*, 464 U.S. 417 (1984) ..... 7

*Southco, Inc.* v. *Kanebridge Corp.*, 390 F.3d 276 (3d Cir. 2004) ..... 11

Constitution, statutes and regulations:

U.S. Const.:

Art. I ..... 2, 7

§ 8, Cl. 8 ..... 2, 7

Statutes and regulations—Continued: Page

Amendment Procedure Act, 5 U.S.C. 701 *et seq.* ..... 2
5 U.S.C. 706(2)(A) ..... 6
5 U.S.C. 706(2)(B) ..... 4, 7
17 U.S.C. 102(a) ..... 2
17 U.S.C. 408a ..... 2
17 U.S.C. 409 ..... 2
17 U.S.C. 410(a) ..... 2
17 U.S.C. 410(b) ..... 2, 5
17 U.S.C. 410(c) ..... 2
17 U.S.C. 701(e) ..... 2, 5
37 C.F.R. 202.1(a) ..... 4, 9, 10

# In the Supreme Court of the United States

No. 07-527

WILLIAM DARDEN, PETITIONER

*v.*

MARYBETH PETERS, REGISTER OF COPYRIGHTS

*ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT*

**BRIEF FOR THE RESPONDENT IN OPPOSITION**

## OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-21a) is reported at 488 F.3d 277. The memorandum and order of the district court granting respondent's motion for summary judgment (Pet. App. 22a-34a) is reported at 402 F. Supp. 2d 638.

## JURISDICTION

The judgment of the court of appeals was entered on May 24, 2007. A petition for rehearing was denied on July 23, 2007. The petition for certiorari was filed on October 22, 2007 (Monday). The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

## STATEMENT

1. The Constitution grants Congress the authority "[t]o promote the Progress of Science and useful Arts,

by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const. Art. I, § 8, Cl. 8. In the Copyright Act of 1976, Congress has provided for the recognition of copyrights in "original works of authorship." 17 U.S.C. 102(a). Under the statutory scheme, a person who claims a copyrightable work may apply to the Register of Copyrights (Register) to have the work registered. 17 U.S.C. 408(a), 409. Congress has directed the Register to register the work if "after examination, the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited constitutes copyrightable subject matter," 17 U.S.C. 410(a), and she is to refuse registration if she determines that "the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason," 17 U.S.C. 410(b). A certificate of registration "constitute[s] prima facie evidence of the validity of the copyright." 17 U.S.C. 410(c). Actions of the Register, with one exception not relevant here, are subject to judicial review pursuant to the Administrative Procedure Act (APA), 5 U.S.C. 701 *et seq.*, 17 U.S.C. 701(e).

2. This is an APA action concerning the Register's refusal to issue a copyright registration for a group of maps showing the States of the United States and, in subsequent state maps, their individual counties (the MAPS work). Petitioner uses those maps on his website so that he can link lists of real estate appraisers to the various locations on the maps. Pet. 4; Pet. App. 2a-3a. Petitioner had the MAPS work created by a contractor who started with public domain digital maps from the United States Census Bureau that depicted the United States, the various States, and the counties within each

State. Pet. 4; Pet. App. 3a. To those Census maps, the contractor added a blue color, shading, and labels (callouts) identifying the States and counties. Pet. 4; Pet. App. 3a. The contractor also smoothed some boundary lines. Pet. 4.

2. Petitioner applied for registration of the MAPS work, as well as the layout of his website, and the Copyright Office refused, asserting that the elements identified by petitioner as having been added to the Census maps were insufficient to meet the requirement for minimally creative expression. Pet. 6; Pet. App. 4a.[1] Petitioner then requested reconsideration from the examiner and subsequently sought review through the Copyright Office's Board of Appeals. At each juncture, the Copyright Office refused registration based on the requirement—set forth in *Feist Publications, Inc.* v. *Rural Telephone Service Co.*, 499 U.S. 340, 341 (1991), and the Copyright Office's regulations—that a work must exhibit minimally creative expression in order to constitute a "work of authorship." The Copyright Office explained that the additions made by petitioner to the Census maps, viewed as a whole, failed to meet the threshold copyright requirement of minimally creative expression. Pet. App. 7a-9a.

3. Petitioner filed this action against the Register in the United States District Court for the Eastern District of North Carolina, pursuant to the APA. On cross-motions for summary judgment, the district court held that the proper standard of review was "abuse of discre-

---

[1] Petitioner's application to register copyright in his website layout was also refused. Pet. App. 4a-5a, 20a-21a. That refusal does not appear to be at issue in the petition however, inasmuch as petitioner's only references are to the Copyright Office's grounds for refusal to register the MAPS work.

tion" and rejected petitioner's argument for *de novo* review. Pet. App. 25a-27a. The court then held that the refusal of registration was consistent with the Copyright Office's regulation, 37 C.F.R. 202.1(a), which denies protection for "names, titles, * * * mere variations of typographic ornamentation, lettering or coloring; [or] mere listing of ingredients," as well as with the Copyright Office's *Compendium of Copyright Office Practices II*. Pet. App. 28a-31a. The court held that "[e]ach of the changes to the existing census maps was in the nature of a shading, coloring or font change"—elements that are not protectable under the Copyright Office's regulations. Pet. App. 29a-30a.

4. The court of appeals affirmed. Pet. App. 1a-21a. The court of appeals first rejected petitioner's argument that the district court should have applied the *de novo* standard of review for determining whether agency action is "contrary to a constitutional right, power, privilege, or immunity." Pet. App. 11a (quoting 5 U.S.C. 706(2)(B)). The court noted that, while the Constitution empowers Congress to provide copyright protection, there is no constitutional right to such protection. Pet. App. 12a.

Reviewing the Register's refusal to register the MAPS work under the APA's abuse-of-discretion standard, the court of appeals upheld the Register's determination that petitioner's "contributions to the preexisting maps resemble the list of examples of uncopyrightable works set forth in 37 C.F.R. 202.1(a)." Pet. App. 18a. The court further rejected petitioner's claim that the Copyright Office failed adequately to consider evidence that other persons had recognized the MAPS work in allegedly infringing copies. The court concluded that recognition of a work by third parties, which, by

definition, occurs *after* the work is created, cannot render it copyrightable; a work is either copyrightable subject matter when created, or it is not. *Id.* at 19a-20a.

## ARGUMENT

The decision of the court of appeals is correct and does not conflict with any decision of this Court or of any other court of appeals. Further review is therefore unwarranted.

1. Petitioner contends (Pet. 8-13), that the court of appeals erred by failing to treat the Register's denial of registration as the denial of a constitutional right, subject to *de novo* review. The court of appeals correctly held that the denial of registration was subject to review under an abuse-of-discretion standard, and that determination does not warrant this Court's review.

Congress has directed the Register of Copyrights to examine works presented for copyright registration and to refuse registration where "the material deposited does not constitute copyrightable subject matter or * * * the claim is invalid for any other reason." 17 U.S.C. 410(b). Section 701(e) of the Copyright Act makes decisions of the Register generally subject to judicial review under the APA. 17 U.S.C. 701(e); see, *e.g.*, *Atari Games Corp.* v. *Oman*, 888 F.2d 878, 879 & n.1 (D.C. Cir. 1989); *Nova Stylings, Inc.* v. *Ladd*, 695 F.2d 1179, 1182 (9th Cir. 1983). See also Pet. App. 9a & n.2 (noting exception to APA review for decisions of the Register whether to authorize reproduction of articles deposited with the Copyright Office).

Petitioner acknowledges the "line of cases that hold the Office to an abuse of discretion review." Pet. 11. Indeed, every court that has reviewed a refusal of copyright registration in an APA action has applied the fa-

miliar abuse-of-discretion standard to such review, as mandated by 5 U.S.C. 706(2)(A), which governs review of informal agency adjudication. *Atari Games Corp.* v. *Oman*, 979 F.2d 242, 243 (D.C. Cir. 1992); *OddzOn Prod., Inc.* v. *Oman*, 924 F.2d 346, 347-348 (D.C. Cir. 1991); *Atari Games Corp.* v. *Oman*, 888 F.2d at 881; *Coach, Inc.* v. *Peters*, 386 F. Supp. 2d 495, 497 (S.D.N.Y. 2005); *Custom Chrome, Inc.* v. *Ringer*, 35 U.S.P.Q.2d 1714, 1716 (D.D.C. 1995); *Homer Laughlin China Co.* v. *Oman*, 22 U.S.P.Q.2d 1074, 1075 (D.D.C. 1991); *Jon Woods Fashions, Inc.* v. *Curran*, 8 U.S.P.Q.2d 1870, 1871 (S.D.N.Y. 1988).[2]

---

[2] In cases where mandamus review of a refusal of registration was sought, prior to the 1976 Copyright Act, the standard for review was also abuse of discretion. *Esquire, Inc.* v. *Ringer*, 591 F.2d 796, 799 n.7, 805-806 (D.C. Cir. 1978), cert. denied, 440 U.S. 908 (1979). See also *Bailie* v. *Fisher*, 258 F.2d 425, 426 (D.C. Cir. 1958) (upholding decision not to register photograph display and noting Register's discretion in determining what may be registered); *Bouve* v. *Twentieth Century-Fox Film Corp.*, 122 F.2d 51, 53 (D.C. Cir. 1941) (the copyright law "establishes a wide range of selection within which discretion must be exercised by the Register in determining what he has no power to accept").

Some courts have held that the Register's refusal of registration is also entitled to deference when the issue is presented in the context of an infringement action, at least one that the Register has joined as a defendant. See, *e.g.*, *John Muller & Co., Inc.* v. *New York Arrows Soccer Team, Inc.*, 802 F.2d 989, 990 (8th Cir. 1986); *Norris Indus., Inc.* v. *International Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir.), cert. denied, 464 U.S. 818 (1983); but cf. *OddzOn Prods.*, 924 F.2d at 347-350 & n.6 (affording deference to refusal to register on APA review, but indicating that plaintiff could obtain "full judicial review" in infringement action) (quoting *Atari Games*, 888 F.2d at 887 (Silberman, J., concurring)). At least one court has held that the court should make an independent determination on the copyrightability issue in the context of an infringement action where the Copyright Office *had* issued a certificate of registration. See *Carol Barnhart, Inc.* v. *Economy Cover*

Petitioner urges (Pet. 12-13) that a different rule should apply when, as in this case, the application for registration is denied on the ground that the work lacks sufficient originality. Petitioner contends that such suits raise a claim that the agency's action is "contrary to constitutional right, power, privilege or immunity," 5 U.S.C. 706(2)(B), and that *de novo* review must therefore be applied. Petitioner reasons that because the requirement of originality derives from Article I, Section 8, Clause 8, of the Constitution, which empowers Congress to provide copyright protection, denial of a copyright on originality grounds is "contrary to constitutional right" and must be reviewed *de novo*. Pet. 13 (quoting 5 U.S.C. 706(2)(B)).

Contrary to petitioner's contentions, denial of copyright for lack of sufficient originality under the Copyright Act raises no constitutional question. The Constitution authorizes Congress to grant copyright protection, and sets as a minimum requirement that such protection may be afforded only to "original" works. *Feist Publications, Inc.* v. *Rural Tel. Serv. Co.*, 499 U.S. 340, 351 (1991) ("originality is a constitutionally mandated prerequisite for copyright protection"). The Constitution does not, however, confer a constitutional right to copyright protection for every work that satisfies the constitutional minimum, much less to copyright registration under the Copyright Act or the presumption of validity that registration entails. *Sony Corp. of Amer.* v. *Universal City Studios, Inc.*, 464 U.S. 417, 431 (1984) ("the protection given to copyrights is wholly statu-

---

*Corp.*, 773 F.2d 411, 413-414 (2d Cir. 1985). That question is not presented in this action, brought under the APA to challenge the Copyright Office's refusal to register. See Pet. App. 16a; *OddzOn Prods.*, 924 F.2d at 347-350.

tory"); see also *Silvers* v. *Sony Pictures Entertainment, Inc.*, 402 F.3d 881, 883-884 (9th Cir.) (en banc) (copyright protection is "a creature of statute"), cert. denied, 546 U.S. 827 (2005). Cf. *Goldstein* v. *California*, 412 U.S. 546, 559 (1973) (recognizing that Congress could decide whether or not to provide copyright protection for certain works). The court of appeals correctly rejected petitioner's attempt to convert every suit challenging "the agency's routine decision to deny registration" into a constitutional case. Pet. App. 11a. See *id.* at 13a ("Essentially, [petitioner] is claiming that the Register simply reached the wrong result, not that the Register applied the wrong legal standard or misapprehended or ignored the controlling legal principles.").[3]

Petitioner is unable to cite any judicial decision, much less one from this Court or another court of appeals, that adopts petitioner's distinction (Pet. 11-12), for purposes of the standard of review, between refusals of registration involving "useful articles" and refusals based on lack of originality. Several of the decisions cited above upheld, under an abuse-of-discretion standard, the Register's determination that the works at issue lacked sufficient minimal creative expression to constitute original works of authorship entitled to copyright protection. See *Coach*, 386 F. Supp. 2d at 498-499 (interlocking letter pattern); *Homer Laughlin China*, 22 U.S.P.Q.2d at 1076 (GOTHIC china pattern). See also *John Muller & Co., Inc.* v. *New York Arrows Soccer*

---

[3] In the analogous field of patents, where Congress's power to confer monopoly rights derives from the same constitutional grant, this Court has recognized that the U.S. Patent and Trademark Office's findings of fact regarding the patentability of an invention are reviewed for substantial evidence in an APA action. *Dickinson* v. *Zurko*, 527 U.S. 150 (1999).

*Team, Inc.*, 802 F.2d 989, 990 (8th Cir. 1986) (holding no abuse of discretion in refusal to register team logo consisting of four lines and cursive word).

Petitioner's contention (Pet. 12-13) that there is a conflict between the decision below and those of the D.C. Circuit in the *Atari* cases is mistaken. As petitioner recognizes (Pet. 12-13), the *Atari* court (per then-Judge Ginsburg) explicitly a plied the deferential abuse-of-discretion standard in reviewing the Register's refusal of registration to the video game "BREAKOUT." 979 F.2d at 243. That the court found an abuse of discretion in that case, holding that the Register failed to account for the sequence of sounds and images (among other elements) appearing in the work, simply confirms that abuse-of-discretion review, while highly deferential, nevertheless constitutes a meaningful review of the agency decision in light of the administrative record. *Id.* at 246-247. Nothing in the court of appeals' decision in the instant case suggests otherwise.

2. Examining the undisputed facts of this case, and the Copyright Office's rationale (as set forth in increasing detail in its decisions during its own appeal procedures), the court of appeals correctly upheld the Register's determination that the MAPS work is not sufficiently original to qualify as copyrightable.

Petitioner admittedly produced MAPS by starting with Census maps containing the outlines of the various States and counties. Pet. 4. To those Census maps, petitioner added blue coloring, labels for geographic placenames (referred to as callouts), and smoothed borders. See Pet. 15; Pet. App. 3a. The Copyright Office's regulations, 37 C.F.R. 202.1(a), list "mere variations of typographic ornamentation, lettering or coloring" as elements that are not considered minimally creative. See

Pet. App. 17a. The court of appeals correctly held, in light of the regulation and the limited changes made by petitioner to the preexisting Census maps, that the Register had acted within her discretion in refusing to register the MAPS work. *Id.* at 18a-20a.

Petitioner's contention (Pet. 13-18) that the court of appeals' decision is in conflict with this Court's opinion in *Feist* and the D.C. Circuit's decision in *Atari* is mistaken. In *Feist*, this Court recognized that a work must contain some minimum amount of creative expression to qualify for copyright, and that trivial or typical elements do not meet the originality requirement. 499 U.S. at 345. In that case, the Court held that "[t]he selection, coordination, and arrangement of [the respondent's] white pages do not satisfy the minimum constitutional standards for copyright protection." *Id.* at 362. The Register's conclusion that the MAPS work lacked sufficient originality to satisfy the statutory and regulatory requirements for registration in no way conflicts with the holding in *Feist*.

While maps are eligible for copyright protection, the court of appeals correctly recognized that not all maps—particularly those derived from public domain maps—are copyrightable. Pet. App. 18a-19a. Here, the aspects added by petitioner to the public domain maps consisted of coloring, labels, and smoothed lines. Those are the very elements that are identified in the Copyright Office's regulation, 37 C.F.R. 202.1(a), as lacking sufficient creative expression to establish a basis for copyright protection. Other courts of appeals have, like the court below, recognized Section 202.1(a) as a reasonable interpretation of copyright law and accorded it deference. See, *e.g.*, *ATC Distribution Group, Inc.* v. *Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700,

709-710 (6th Cir. 2005); *Southco, Inc.* v. *Kanebridge Corp.*, 390 F.3d 276, 285-287 & n.5 (3d Cir. 2004) (en banc) (specifically according deference to section 202.1(a) as reflecting the "body of experience and informed judgment" of the agency) (citation omitted); *CMM Cable Rep., Inc.* v. *Ocean Coast Props., Inc.*, 97 F.3d 1504, 1519-1520 & n.21 (1st Cir. 1996) (noting that regulation is a fair summary of the law). The decision below accords with those holdings of other circuits.

Neither is there any conflict with *Atari*. In *Atari*, the D.C. Circuit reviewed the refusal of registration for abuse of discretion, but held that the Register had failed to account for the sequence of graphical screens and accompanying sounds that comprised the BREAKOUT video game. 979 F.2d at 245-247. Thus, the refusal of registration was held to be an abuse of discretion because it lacked a rational basis. *Id.* at 247. Here, the Copyright Office explained, in increasing detail through its internal appeal process, why the coloring, labeling, and line smoothing added by petitioner was insufficient, taken as a whole, to meet the minimal creativity requirement. Pet. App. 6a-9a, 18a. The Copyright Office's judgment represents a reasonable application of the *Feist* principle requiring some minimal creativity to the MAPS work, in light of the Copyright Office's longstanding regulations. See *Coach*, 386 F. Supp. 2d at 498-499.

Finally, the court of appeals properly rejected petitioner's argument (Pet. 18-20) that alleged confusion between its MAPS work and copies displayed by competitors conclusively demonstrated an abuse of discretion because it showed that the MAPS work was unique. The court of appeals correctly recognized that alleged source identification is not part of the test for copyrightability, because, by definition, source identifi-

cation could not exist at the time of the work's creation. See Pet. App. 19a ("a work is copyrightable at the time of its creation or not at all"); *Coach*, 386 F. Supp. 2d at 499 (rejecting similar argument regarding "C" logo). Just as a single letter, such as a "C," or a single color, such as the pink color of a brand of insulation, might be recognized as a source indicator, and might, in appropriate circumstances, be afforded trademark protection, according copyright protection to such attributes would vitiate the Copyright Office's longstanding regulation and interpretation of copyright law as forbidding copyright protection for a letter or a color.

## CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

PAUL D. CLEMENT
*Solicitor General*

JEFFREY S. BUCHOLTZ
*Acting Assistant Attorney General*

JOHN J. FARGO
ANTHONY J. STEINMEYER
JOHN S. KOPPEL
*Attorneys*

TANYA M. SANDROS
*General Counsel*

ROBERT KASUNIC
*Attorney*
*U.S. Copyright Office*

JANUARY 2008